RECORD AND BRIEFS

SEP 14 2016

No. 15-866

IN THE

Supreme Court of the United States

STAR ATHLETICA, L.L.C.,

Petitioner,

v.

VARSITY BRANDS, INC., ET AL.,

Respondents.

On Writ of Certiorari
to the United States Court of Appeals
for the Sixth Circuit

BRIEF FOR THE RESPONDENTS

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QUESTION PRESENTED

The Court granted certiorari on the following question:

What is the appropriate test to determine when a feature of the design of a useful article is protectable under § 101 of the Copyright Act?

CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6, respondents state:

Varsity Brands, Inc. (n/k/a Varsity Brands, LLC), Varsity Spirit Corporation (n/k/a Varsity Spirit LLC), and Varsity Spirit Fashion & Supplies, Inc. (n/k/a Varsity Spirit Fashion & Supplies, LLC) are indirect subsidiaries of Hercules VB Holdings, Inc. No publicly held company owns 10% or more of any of the respondents.

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BRIEF FOR THE RESPONDENTS

Not every separability case is "vexing." Pet. for Cert. 5. This case is governed by a straightforward rule that has been well established in copyright law for more than 50 years: an original two-dimensional graphic or pictorial design is copyrightable, whether it appears on an artist's canvas, a canvas bag, or a canvas shirt. The two-dimensional design does not lose copyright protection when it is applied to a bag, shirt, or other three-dimensional "useful article"—including a cheerleading uniform. At a minimum, such a two-dimensional design is "separable" from the three-dimensional article's utilitarian functions.

Courts, commentators, and the Copyright Office have all followed that rule since well before the Copyright Act of 1976 ("Act"), and Congress ratified the rule in adopting the statute now before the Court. Congress protected original "pictorial, graphic, and sculptural works" and defined that category to include much more than "fine art." Copyrightable works also include "applied art"—*i.e.*, designs that have been applied to something else—and even "the design of a useful article," if its "pictorial, graphic, or sculptural features . can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. §§ 101, 102(a)(5). Two-dimensional artwork easily qualifies as a copyrightable "pictorial, graphic, or sculptural work." Such a work is "still capable of being identified"—and retains its independence—"when it is printed or applied to utilitarian articles such as textile fabrics [or] containers." H.R. Rep. No. 94-1476, at 55 (1976) (House Report).

That rule resolves this case. Respondents (Varsity) registered original, two-dimensional graphic artwork. Varsity incorporates some of those graphic designs onto cheerleading uniforms and other garments, but each design remains separable from the clothing on which it appears. Therefore, Varsity's graphic designs are eligible for copyright protection.

Petitioner Star Athletica, L.L.C. (Star) premised its certiorari petition on a need to clarify when an artistic feature is separable from a useful article, but its merits brief offers no clarity at all. Star proposes an indeterminate hodge-podge of lower-court tests, turning mainly on subjective or speculative factors like what a designer intended or whether customers might buy the design. And then Star insists that in doubtful cases—exactly what Star's murky tests will produce—courts should presume that a design element is not copyright-eligible. Neither the tests nor the tiebreaker has any support in the statute. Even Star admits that its approach is "sub-optimal" and would fail to protect "features one would expect are copyrightable." Star Br. 39 (quotation marks and citation omitted). Indeed, under Star's approach, even art that *this Court has held is copyrightable* would receive no protection.

There is no reason to layer onto the statutory text a complex, multi-part test that its proponent admits will often yield the wrong result. The court of appeals correctly held that Varsity's two-dimensional graphic designs are eligible for copyright protection. Its judgment should be affirmed.

STATEMENT

A. Congress Protects Works of Applied Art.

The Copyright Act of 1976 protects multiple types of authorship from copying, including categories of expression outside of what might be considered "pure" art. In particular, the Act allows authors to register "applied art," including the separable pictorial, graphic, and sculptural features of the designs of useful articles. 17 U.S.C. § 101 (definition of "pictorial, graphic, and sculptural works"). In adopting these protections, Congress ratified this Court's decision in *Mazer v. Stein*, 347 U.S. 201 (1954), which interpreted an earlier version of the Act to protect applied art created for commercial purposes. The pre-1976 interpretations by this Court and the Copyright Office thus provide an essential backdrop to the statutory provisions at issue in this case.

1. In *Mazer*, this Court confronted the question whether statuettes that were "intended primarily" for use as lamp bases were eligible for copyright protection. 347 U.S. at 202, 204-05. The Court explained that Congress had abolished any distinction between "purely aesthetic articles and useful works of art," including by deleting from the statute (in 1909) language limiting protection to "fine" art. *Id.* at 211, 213. The Court endorsed an existing Copyright Office regulation, which allowed authors to register "'works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned.'" *Id.* at 212 (quoting 37 C.F.R. § 202.8 (1949)). Under this standard, the statuettes were protected: they qualified as works of art, and "their intended reproduction as lamp stands" did not

"bar[] or invalidate[] their registration." *Id.* at 214; *see id.* at 218-19.

The Court rejected the infringer's argument that the statuettes could only be protected under the design-patent laws, not the copyright laws. *Mazer*, 347 U.S. at 215-18. The Court held that design patents and copyrights provide different protections, *id.* at 217-18, and that those protections are not mutually exclusive: "Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted." *Id.* at 217.

2. a. The Copyright Office responded to *Mazer* in a series of regulations, policy statements, and reports. In 1956, the Copyright Office added two new paragraphs to the regulation discussed in *Mazer*. The first new paragraph (paragraph b) provided that registrability was not affected by several irrelevant characteristics including "the intention of the author as to the use of the work," whether the work "appears on a textile material or textile product," and whether the work could receive design-patent protection. 37 C.F.R. § 202.10(b) (1956). The second new paragraph (paragraph c) provided that a work's status as "a useful article" did "not preclude its registration," but that "[w]hen the shape of an article is dictated by, or necessarily responsive to, the requirements of its utilitarian function," the shape could not receive protection. *Id.* § 202.10(c).

Paragraph c was controversial because it arguably applied a more restrictive standard than the *Mazer* Court had endorsed. *See* 2 William F. Patry, *Patry on Copyright* § 3:132, at 3-400, 3-401 (Mar. 2016) (Patry). In 1959, the Copyright Office responded by amending the regulation to delete the "dictated by or

responsive to" test. The revised paragraph c provided:

> (c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

37 C.F.R. § 202.10(c) (1959).

b. Following *Mazer*, the Copyright Office consistently registered two-dimensional artwork that appeared on the surface of useful articles. Shortly after *Mazer*, the Copyright Office announced "that it would permit the registration of a work of art embodied in a textile fabric . . regardless of the intended use of the material on which any given work of art may have been reproduced or embodied." 57 U.S. Copyright Office Ann. Rep. Reg. Copyrights 6 (1955). More generally, the Office explained that the protection available to pictorial, graphic, or sculptural works was "not affected by use of the work as a design or decoration of a useful article"; as a result, two-dimensional "painting[s] reproduced on textile fabrics" could be registered, even though "wearing apparel" and other useful articles "as such" could not. H. Comm. on the Judiciary, 87th Cong., *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* 13-15 (Comm. Print 1961).

The Copyright Office participated extensively in the drafting of the new Copyright Act, and in its final report to Congress, the Office reaffirmed its policies. In particular, the Office explained that under *Mazer* and Office regulations:

> virtually all original two-dimensional designs for useful articles, such as textile fabrics, wallpaper, floor tiles, painted or printed decorations, and so forth, were subject to copyright registration.

Copyright Law Revision: Hearings Before the Subcomm. on Courts, Civil Liberties and the Administration of Justice of the House Judiciary Comm. on H.R. 2223, 94th Cong., Pt. 3, at 1857 (1975) (*1975 Register's Report Hearing*) (statement by Barbara Ringer, Register of Copyrights, reviewing the Second Supplementary Register's Report on the General Revision of the U.S. Copyright Law). The Office noted that "three-dimensional designs" were also eligible for registration, but only if they could "be conceptually separated and are capable of existing independently of the utilitarian aspects of the article embodying them." *Ibid.*

c. Consistent with Copyright Office policy, courts during the pre-1976 period consistently held that original designs appearing on useful articles such as clothing were eligible for protection. *See, e.g., Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 488 (2d Cir. 1960) (L. Hand, J.) (upholding an injunction against infringement of a copyright for an "ornamental design, printed upon cloth" and "used in the manufacture of women's dresses"); *Irving J. Dorfman Co. v. Borlan Indus., Inc.*, 309 F. Supp. 21, 23 (S.D.N.Y. 1969) ("It is now settled that textile design is a proper subject for copyright protection.").

3. After two decades of study, Congress adopted the Copyright Act of 1976. The relevant provisions preserved existing protections for applied art and permitted the registration of the separable artistic features of useful articles, including two-dimensional designs appearing on useful articles.

a. Congress provided that protectable works include "pictorial, graphic, and sculptural works," 17 U.S.C. § 102(a)(5), and it defined that category in a way that ratified existing law established by *Mazer* and Copyright Office regulations. *See* House Report 54-55. The resulting definition provides:

> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art .... Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article . shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101. Congress combined the "classic language" from the 1948 regulations endorsed in *Mazer* with language from the Copyright Office's 1959 regulation. House Report 54-55. But unlike the regulations, the statute provides that the artistic design must be separable from "the *utilitarian aspects* of" the useful article, not the useful article as a whole—a change that resulted in a "much more liberal" standard for copyright protection. 2 Patry § 3:146, at 3-473.

Congress also defined a "useful article" as:

> an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article."

17 U.S.C. § 101.

The House Report explained that the definition of "pictorial, graphic, and sculptural works" was intended "to draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design." House Report 55. On the applied-art side of the line were "two-dimensional painting[s], drawing[s], or graphic work[s]," because they were "still capable of being identified when printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like." *Ibid.* On the other side were the designs of the overall "shape of . industrial product[s]," such as "the shape of an automobile, airplane, ladies' dress, food processor, [or] television set"; such three-dimensional designs could not be registered unless they "contain[ed] some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of the article." *Ibid.* For example, the House Report explained that the definition would protect "a carving on the back of a chair or a floral relief design on silver flatware," but not the overall shape of the chair or flatware. *Ibid.*

b. Congress also considered whether to adopt separate provisions to protect the *nonseparable* ornamental designs of useful articles—*i.e.*, to extend

copyright protection to useful articles as such, including their overall shape. *See* S. Rep. No. 94-473, at 49-50, 161-62 (1975). The Senate included a separate title for ornamental design protection (Title II) in its copyright-reform bill. The proposal included a "saving clause" stipulating that new design protection would not alter existing copyright protections available for the artistic features of useful articles. *Id.* at 87, 166; *see also* House Report 50 (explaining that the Senate proposal would have granted protection without regard to separability). Ultimately, the Copyright Act was enacted without Title II. *See ibid.*

4. Since the 1976 Act was adopted, the Copyright Office has read section 101 to ratify and continue the Office's consistent policies for registering the separable (and original) artistic features of useful articles. In particular, the Copyright Office has recognized that two-dimensional designs appearing on useful articles should be registered, such as "[a]rtwork printed on a t-shirt, beach towel, or carpet," or "[a] colorful pattern decorating the surface of a shopping bag." Compendium of U.S. Copyright Office Practices § 924.2(B), at 900:40-41 (3d ed. 2014) (Compendium III). These examples satisfy the Office's test for separability, which provides that even if an artistic feature is not physically separable, it is eligible for registration if the artistic feature is "capable of being visualized" as "independent from the overall shape of the useful article"—*i.e.*, "the artistic feature and the useful article could both exist side by side and be perceived as fully realized separate works." *Ibid.*

Following notice and comment, the Copyright Office has applied these policies to one specific type of clothing. Registrability of Costume Designs, 56 Fed.

Reg. 56,530 (1991). The Office confirmed that garments (including costumes) are useful articles that may not themselves be copyrighted, but that any separable artistic features—such as a "two-dimensional design applied to the surface of the clothing"—may be registered. *Id.* at 56,531-32.

B. Varsity Registers Two-Dimensional Graphic Designs.

1. Varsity is the leading manufacturer of cheerleading apparel and accessories. Varsity devotes significant time and resources to developing original two-dimensional graphic designs to be featured on the company's garments. J.A. 237-39. From 1985 to 2013, Varsity obtained over 200 copyright registrations for original two-dimensional graphic designs. J.A. 283, 310-11.

Graphic design and garment production are separate functions within the company. J.A. 257-58, 283. Varsity's design team begins by creating two-dimensional sketches on paper. J.A. 281. Designs include the "selection, placement, and arrangement of elements, such as stripes, lines, chevrons, inverted chevrons, angles, curves, coloring, and shapes." *Ibid.* Of the designs produced, only a portion are selected for potential use; they are conveyed to the production department to implement on cheerleading uniforms and other garments. J.A. 258, 282. The particular design selected does not affect the fit of a uniform, because the garment itself is produced using a "standard base" that does not vary with the design placed on it. J.A. 284, 292.

Two-dimensional graphic designs can be applied to cheerleading uniforms and other garments in various

ways, including by (1) cutting and sewing together panels of colored fabric; (2) sublimating the design by transferring colored ink onto plain fabric through a heating process; (3) embroidering the design onto the fabric; and (4) screen printing, which involves spraying ink onto the surface of the garment. J.A. 243. Varsity primarily uses the "cut-and-sew" and sublimation methods. *Ibid.* Sublimation is an increasingly important technique in Varsity's business; uniforms made using sublimation accounted for more than $600,000 in revenue in 2011 and more than $1.2 million in 2012. J.A. 244.

Regardless of the production method used, designers are not constrained by functional concerns about garment construction, except to the extent that the edges of a garment serve as the edges of the designer's canvas. J.A. 283-84. In fact, Varsity's designers do not know when creating a design whether the production department will use the cut-and-sew or sublimation method. J.A. 239, 282. All five designs at issue in this case can be and have been incorporated onto uniforms through both methods. J.A. 244, 260, 262-70. If the production department produces a garment that does not accurately reproduce the original design, it is rejected and the production department starts over. J.A. 258, 283.

Customers select from among Varsity's many "interchangeable" two-dimensional designs, and then customize the colors, shape, and braiding for the garment on which the selected pattern will appear. Pet. App. 4a, 45a-46a. Varsity's graphic designs can be, and have been, applied to many products other than cheerleading uniforms. J.A. 242-43, 258, 261, 273-79, 281. For example, Varsity has applied its

designs to jackets, practice wear, and warm-ups. *Ibid.*

2. As noted, p. 10, *supra*, Varsity has registered hundreds of original two-dimensional graphic designs. J.A. 283, 310-12. Registering these designs has involved extensive back-and-forth between the Copyright Office and Varsity.

The Copyright Office registered more than 50 of Varsity's designs (not at issue here) following an initial rejection. J.A. 246. Contrary to Star's assertion (at 15), the initial refusal was based on questions about originality, not separability. J.A. 149. Varsity requested reconsideration, and the Copyright Office concluded that Varsity could register the designs "appearing on the surface" of the articles of clothing depicted, which consisted in the "creative **separable** artistic or graphic authorship in the treatment and arrangement of the preexisting elements" (*i.e.*, the shapes and patterns) "coupled with their coloring." J.A. 66, 322; *accord* J.A. 316.

3. This case involves the infringement of five of Varsity's two-dimensional graphic designs: Designs 074, 078, 0815, 299A, 299B. J.A. 18; *see* J.A. 32, 70, 81-83. Each of those designs is depicted in "deposit materials" submitted to the Copyright Office. For designs 074, 078, and 0815, the deposit materials depict the designs as sketched on silhouettes; for designs 299A and 299B, the deposit materials are photographs of sample garments with the designs on the surface. J.A. 213-15.[1] All five certificates of regis-

[1] As discussed below, pp. 59-60, *infra*, deposit materials may include a photograph of a three-dimensional article on which

tration describe the nature of the works as "2 Dimensional artwork"; two add the further description "fabric design (artwork)." J.A. 38-39, 46, 48-50, 57-59, 71-72. Three of the designs (074, 078, and 0815) were registered by the Copyright Office within five years after first publication, entitling them to a presumption of validity under 17 U.S.C. § 410(c). Pet. App. 15a.

C. Star Copies Varsity's Designs By Taking Advantage of a Former Varsity Employee's Access.

Star was formed in 2010; its founders included a former Varsity employee, Kerry Leake. J.A. 221-22. During his years at Varsity, Leake had access to all of the company's catalogues from 1998 to 2009. J.A. 248. The five designs at issue here were all published during that period. *Ibid.*

At Star, Leake was responsible for deciding which designs to use in the company's 2010 catalogue, as well as for supervising uniform production. J.A. 223. Leake has admitted that he reviewed Varsity's catalogues when preparing Star's 2010 catalog. J.A. 348-49. Upon review of Star's catalogue and its website, Varsity employees recognized that Star had copied, reproduced, and displayed the five registered designs at issue here by incorporating the designs onto the surface of Star's cheerleading uniforms. J.A. 18, 33-37, 68-70.

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the two-dimensional work appears, but that does not mean that a copyright is claimed in the three-dimensional article.

D. Varsity Asserts Its Copyrights.

1. Varsity filed suit against Star, asserting, *inter alia*, five claims for copyright infringement. J.A. 21-25. The district court denied Star's motion to dismiss, and also granted Varsity's motion to dismiss Star's antitrust counterclaim. J.A. 84-103, 164-68. Following discovery, the parties cross-moved for summary judgment. Pet. App. 11a. With respect to Varsity's copyright claims, Star argued that Varsity's designs were not protected because the designs were for useful articles and were not separable from the utilitarian aspects of cheerleading uniforms. *Id.* at 11a-12a.

2. The district court granted summary judgment to Star on Varsity's copyright claims. Pet. App. 58a-78a. The district court identified its "central" task as defining "the essence of a 'cheerleading uniform,'" which the court compared to an exercise in "[c]lassical philosophy." *Id.* at 58a (citing Plato, *The Republic* (Benjamin Jowett trans., Vintage Books 1991)). The court held that Varsity's two-dimensional graphic designs are not eligible for copyright protection because they supposedly are not separable from the cheerleading uniforms on which they appear. *Id.* at 59a. The district court acknowledged Varsity's argument that a "blank cheerleading silhouette" could cover the body just as well as any other cheerleading uniform. *Id.* at 74a. But the court thought this was irrelevant, because the designs supposedly were too closely associated with "the ideal" of "cheerleading-uniform-ness" to be copyrighted. *Id.* at 59a, 75a.

3. The Sixth Circuit reversed. Pet. App. 1a-53a. The court held that Varsity's designs are eligible for copyright as graphic works.

a. After determining that Varsity's designs were "works of graphic . . art" and designs of useful articles, Pet. App. 42a, the Sixth Circuit turned to identifying the relevant "utilitarian function" of Varsity's garments as "cover[ing] the body, wick[ing] away moisture, and withstand[ing] the rigors of athletic movements." *Id.* at 43a. The court rejected Star's much broader view of function—"identify[ing] the wearer as a cheerleader"—because the statute expressly excludes the mere "'convey[ing] [of] information'" from the definition of "useful article." *Ibid.* (quoting 17 U.S.C. § 101). Likewise, the court rejected Star's contention that designs that serve a "decorative function" on clothing are purely utilitarian and uncopyrightable because that argument contradicted "well-established" law recognizing that fabric designs are eligible for copyright. *Id.* at 44a.

Applying its understanding of function, the court concluded that Varsity's designs could exist independently of the uniforms, because they are transferable to other surfaces, including other apparel. Pet. App. 46a-47a. And cheerleading uniforms can exist without Varsity's graphic features—indeed, record evidence "establishe[d]" that "not all cheerleading uniforms must look alike to be cheerleading uniforms." *Id.* at 45a-46a.

b. Judge McKeague dissented. Pet. App. 53a-57a. He would have held that "the stripes, braids, and chevrons on a cheerleading uniform" were not copyrightable because they cannot be separated from

what he saw as a cheerleading uniform's "identifying function." *Id.* at 54a-56a.

SUMMARY OF ARGUMENT

The court of appeals correctly held that Varsity's two-dimensional graphic designs are eligible for copyright protection, and that they do not lose that protection merely because they appear on three-dimensional cheerleading uniforms. The rule that original two-dimensional designs appearing on useful articles can be registered and receive copyright protection is firmly rooted in copyright law, and it follows clearly from the text of the Copyright Act. Any plausible test for deciding whether artistic features of the designs of useful articles are separable from the article's utilitarian aspects should be consistent with this established rule.

I. The text of the Act asks whether the design of a useful article has identifiable pictorial, graphic, and sculptural features that are capable of existing independently of the utilitarian, non-expressive aspects of the article. Independence is established if an artistic feature is either physically separable from the useful article (*e.g.*, a hood ornament on a car) or conceptually separable (*e.g.*, a carving on the back of a chair). Two-dimensional artwork appearing on a useful article was considered a clear example of a copyright-eligible work at the time Congress adopted the current statute, and such works easily qualify as conceptually separable under the statutory standard. A two-dimensional graphic design can be moved from a useful article to a canvas, or an iPhone cover; the design is entirely independent from the useful functions of the original article, which do not depend on

adornment. That is the Copyright Office's approach, and that longstanding, considered judgment warrants respect.

II. Star admits that its separability test is suboptimal and under-protective, yet it provides no support for such an undesirable outcome in the statute or its history. Instead, Star takes two different conceptual-separability tests from lower-court decisions, each of which is already flawed standing alone, and lumps them together into something even less clear—but at least as flawed. Star's approach is divorced from the statutory text and would deny protection to paradigmatic examples of copyright-eligible works, including even the lamp-base statuette from *Mazer*.

Attempting to resolve the ambiguity its chimerical test creates, Star invents various presumptions against copyrightability, but none has any basis in the text. Star contends (at 31, 38-39) that there is a wall between aesthetics and function—such that original artistic features would be ineligible for copyright protection if they advance an article's utility "even slightly." But requiring complete blindness to practicalities would leave nothing protected except fine art, whereas the statute robustly protects *applied* art as well. None of the policy concerns that Star invokes justify its stingy approach to copyright protection. To the contrary, denying copyrights to original, separable designs would leave authors of applied art defenseless against copying, undermining their incentive to create original works.

In addition, Star's approach treats decoration and identification as "utilitarian aspects" of useful articles. That contradicts the statutory definition of

"useful article" and the ordinary meaning of "utilitarian." "Looking good" is not a utilitarian function under the statute; if it were, utility would completely subsume aesthetics.

III. Varsity's two-dimensional graphic designs are eligible for copyright protection. To begin with, the designs are not designs *of* useful articles at all; they are designs that appear *on* useful articles. But to the extent separability analysis applies, Varsity's designs are clearly separately identifiable from and capable of existing independently of the utilitarian aspects of cheerleading uniforms. In fact, Varsity has reproduced the designs on other garments such as warm-ups and jackets.

Nor can Star show that cheerleading uniforms somehow specially require stripes and color blocks in a way that no other useful article does. Contrary to Star and the district court, conveying "cheerleading uniform-ness" is not a utilitarian function.

That leaves just Star's factual quibbles about whether Varsity's registrations really are for two-dimensional graphic designs. The registration documents and Varsity's correspondence with the Copyright Office about similar designs leave no doubt that they are.

ARGUMENT

Original two-dimensional artwork and graphic designs do not forfeit copyright protection if they are applied to useful articles, such as clothing. Varsity sought and received protection for two-dimensional graphic designs, not for the overall shape of a uniform. The graphic designs are not themselves de-

signs of useful articles, and they are easily separable from the articles of clothing on which they appear because, like other two-dimensional artwork, they are identifiable separately from the garments and are capable of existing on an entirely different medium.

I. The Copyright Act Protects Applied Art, Including The Separable Artistic Features Of The Designs Of Useful Articles.

The Copyright Act of 1976 codified the protection this Court's *Mazer* decision afforded to original works of applied art, notwithstanding the art's commercial origins and purposes. Under the text of the Act original pictorial, graphic, and sculptural features that appear in or on useful articles receive protection, provided they are physically or conceptually separable from the article's utilitarian (*i.e.*, practical, non-decorative) aspects. Two-dimensional artistic designs that appear on a useful article (such as clothing) are eligible for protection under this standard. That result follows clearly from the text of the Act and the legislative history, and it is supported by the consistent practice of the Copyright Office stretching back for decades.

A. Separability Analysis Focuses On The Identifiable Artistic Features Of A Useful Article And Asks Whether They Could Exist Independently Of The Functions That Make An Article Useful.

1. The proper starting point for determining copyright eligibility is "the language of the statute." *Allison Engine Co. v. United States ex rel. Sanders*, 553

U.S. 662, 668 (2008). Under section 102(a)(5), "[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression," including "pictorial, graphic, and sculptural works." 17 U.S.C. § 102(a)(5). Thus, if Varsity's designs are "pictorial, graphic, [or] sculptural works," they are copyright-eligible.

"Pictorial, graphic, and sculptural works" (PGS works) are defined to include, *inter alia*, "two-dimensional and three-dimensional works of fine, graphic, and applied art." *Id.* § 101. "[A]pplied art" is not defined by the statute, but its ordinary meaning is art "put to practical use," *i.e.*, art "employed in the decoration, design, or execution of useful objects." *Webster's Third New International Dictionary* 105 (1976).[2] By contrast, "fine art" describes art "that is concerned primarily with the creation of beautiful objects," *i.e.*, art for art's sake where "aesthetic purposes are primary or uppermost." *Id.* at 852.

Consistent with the ordinary meaning of "applied art," section 101's definition of PGS works includes "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned." 17 U.S.C. § 101; *see also* pp. 3-4, *supra* (describing the regulation discussed in *Mazer*, which used this same language). The definition further specifies that "the design of a useful article" is also a PGS work, with the proviso that the work is protected "only to the extent that" the "design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of exist-

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[2] *Accord* Compendium III § 503.1(BA), at 500:7 (applied art is "artwork applied to a useful article").

ing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101.

"[U]tilitarian" is not defined in the statute, but it ordinarily means "useful or practical rather than attractive." *Concise Oxford English Dictionary* 1594 (Angus Stevenson & Maurice Waite eds., 12th ed. 2011); *see also Webster's Third New International Dictionary* 2525 ("characterized by or aiming at utility as distinguished from beauty or ornament"); *The American Heritage Dictionary* 1331 (2d College ed. 1985) ("1. Pertaining to or associated with utility." "2. Stressing the value of practical over aesthetic qualities."). This ordinary meaning fits with the statute's definition of "useful article[s]" as articles that have "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101.

The Copyright Act thus makes clear that pictorial, graphic, and sculptural artworks are copyright-eligible even when the works have a practical use. But protection does not extend to purely practical features.

2. Under section 101, the focus of the separability inquiry is on the claimed pictorial, graphic, and sculptural features of a useful article. So long as the artistic features can be "identified separately from" the non-decorative, practical aspects of a useful article, and it is possible to imagine the artistic features existing "independently of" those functional aspects, the artistic features qualify as PGS works. 17 U.S.C. § 101. The statute does not *also* require that the useful article would retain its functionality without the artistic features. *See* 2 Patry § 3:146, at 3-474 (explaining that "it should not matter" under the statu-

tory text "what happens to" the "functional elements" of an article if the protectable, artistic features are removed). To use *Mazer* as an example, the relevant question would be whether the statuette is identifiable separately from, and could exist independently of, the lamp's utilitarian features. The copyright owner would not also be required to show that the lamp could function as a lamp without the sculptural base.

The overall structure of the Act reinforces section 101's focus on the PGS features of the useful article for determining separability. Section 102(a) establishes that copyright protection extends to works of authorship "fixed in any tangible medium." 17 U.S.C. § 102(a). And section 113(a) provides that an author's exclusive right to reproduce a copyrighted PGS work "includes the right to reproduce the work in or on any kind of article," including a "useful" article. *Id.* § 113(a). Under both provisions, the Act presupposes that protection for an author's original work does not depend on the particular medium she elects to work in. Likewise, section 101's separability test allows an author to claim protection for identifiable (and original) PGS features in or on useful articles where it is possible to imagine those features in or on a different medium.

B. Either Physical Or Conceptual Separability Satisfies the Statutory Requirement.

As even Star agrees (at 38-39), section 101's separability test looks at more than just whether a pictorial, graphic, or sculptural feature can be *physically* removed from the useful article. Physical-separability cases are easy: the fact that a decorative hood ornament can be physically removed from a

car without altering the ornament's artistic features demonstrates that it can exist and be identified separately from the car's utilitarian aspects. *See* Compendium III § 924.2(A), at 900:40 (using this example). But as the Copyright Office has correctly recognized, the statute does not *require* physical separability. *Id.* § 924.2, at 900:39-41.

Pictorial, graphic, or sculptural features of a useful article's designs are also copyright-eligible PGS works if they are "conceptually" separable from the article's utilitarian aspects. This follows directly from the statutory text, which asks whether an artistic feature is "*capable* of existing independently" of the article's utilitarian aspects. 17 U.S.C. § 101 (emphasis added).[3] And there is no reason to read such a requirement of "physical independent existence" into a statute that protects *intangible* intellectual property. *See* 2 Patry § 3:146, at 3-473 to 3-475.

The Copyright Act's legislative history directly supports recognizing physical and conceptual separability as alternative, independently sufficient tests. Not only does the House Report indicate that artistic elements of useful articles should receive protection if they are "physically *or* conceptually" separable, House Report 55 (emphasis added), but several of the Report's paradigmatic examples of copyright-eligible works depend on conceptual separability. For instance, neither "a carving on the back of a chair" nor "a floral relief design on silver flatware," *ibid.*, is

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[3] A PGS feature must also be "identifi[able]" separately from the article's utilitarian aspects, 17 U.S.C. § 101, but as Star acknowledges, this requirement is generally "easy" to satisfy. Star Br. 32; *see also* p. 27, *infra*. Certainly, identifiability does not require physical separability.

physically separable from the chair or the flatware, respectively. Yet both designs are copyright-eligible PGS works because they could exist independently of the useful articles' utilitarian aspects: the same carving or design could readily appear on items not used for sitting or eating.

The Copyright Office's "side-by-side" analysis correctly implements conceptual separability. An artistic feature can be "identified separately from" the useful article's practical features if the artistic feature is "capable of being visualized—either on paper or as free-standing sculpture—as a work of authorship that is independent from the overall shape of the useful article." Compendium III § 924.2(B), at 900:40. And the artistic feature is "capable of independent existence apart from" the utilitarian features if the artistic feature can "exist side by side" with the useful article after being separated, and still be "perceived as [a] fully realized, separate work[]." *Ibid.*[4]

C. Two-Dimensional Artwork On Useful Articles Is Inherently Separable.

Star asserts that the lower courts have "'twisted themselves into knots'" attempting to develop and apply an appropriate test for conceptual separability. Star Br. 11 (citation omitted). But whatever difficulty courts have had applying the statutory text to borderline cases involving *three*-dimensional designs, *two*-dimensional designs make for an easy case. *See*,

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[4] Nothing in this case turns on whether the useful article, too, must still be a fully realized, separate work. *See* p. 54, *infra*. But the text asks only whether the PGS work is separable from the utilitarian elements, not vice versa. *See* pp. 21-22, *supra*.

e.g., *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1413 (11th Cir.), *cert. denied*, 136 S. Ct. 232 (2015) (explaining that it is "obviously true" that "any two-dimensional image" is separable from the useful article on which it is appears); 2 Patry § 3:150, at 3-478, 3-479 (explaining that "two-dimensional works can be applied to useful articles" and should receive protection);[5] 1 Paul Goldstein, *Goldstein on Copyright* § 2.5.3, at 2:83 (3d ed. 2005) (Goldstein) ("[I]t is relatively easy to obtain copyright protection for designs of useful articles appearing in two-dimensional rather than three-dimensional form."). This follows from a straightforward reading of the statutory text, and it is further supported by the Act's historical backdrop and legislative history.

1. In many cases involving two-dimensional works, the separability test does not apply at all. Separability is only implicated when a PGS work is the "design of a useful article." 17 U.S.C. § 101. Two-dimensional PGS works that are "applied to" useful articles are not themselves the designs *of* useful articles. *See* 2 Patry § 3:150, at 3-479. Moreover, the statute expressly provides that PGS designs do not lose their protection when they appear "in or on" a useful article. 17 U.S.C. § 113(a).

As a result, the status of these two-dimensional designs as PGS works—and their eligibility for copyright if they are original—does not depend on sepa-

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[5] Star claims (at 43) that its test "subsumes" Patry's, but Star omits Patry's discussion of two-dimensional works. Star also fails to mention that Patry endorses the result of the Sixth Circuit's decision *in this case* precisely because it involves two-dimensional graphic designs. *See* 2 Patry § 3:151, at 3-481; *see also* p. 52, *infra*.

rability. *See* 2 Patry § 3:151, at 3-485 ("Courts looking at two-dimensional design claims should not apply the separability analysis regardless of the three-dimensional form that design is embodied in."); Jane C. Ginsburg, *"Courts Have Twisted Themselves Into Knots": U.S. Copyright Protection for Applied Art*, 40 Colum. J.L. & Arts __ (forthcoming Nov. 2015) (courts properly "avoid[] inquiry into conceptual separability" when presented with a "PGS work on a useful article").

2. To the extent the separability test applies, two-dimensional artwork appearing on a useful article will easily satisfy it. By their nature, two-dimensional designs can appear on a variety of different media. As a result, it is "obviously true" that they can be identified separately from, and are capable of existing independently of, the utilitarian aspects of any three-dimensional useful article on which they happen to appear. *Home Legend*, 784 F.3d at 1413 (noting that "two-dimensional image" serving as flooring decoration "might as easily be applied to wallpaper[,] or as the veneer of a picture frame," or even "hung on a wall as art" (quotation marks omitted)); *see also* 1 Goldstein § 2.5.3, at 2:83 (recognizing that two-dimensional designs "will inevitably be at least conceptually separable from the paper or fabric on which they are printed"). Moreover, the "functions" of two-dimensional art itself typically are purely decorative or communicative, not utilitarian, which makes such artwork inherently separable from a useful article's "utilitarian aspects." *See also* Part II.B, *infra* (explaining why decoration and communication are not "utilitarian" under the Act).

3. In light of the Act's historical backdrop, it should not be surprising that two-dimensional designs appearing on useful articles are copyright-eligible PGS works. As the Copyright Office reported to Congress in 1975, "virtually all original two-dimensional designs for useful articles, such as textile fabrics, wallpaper, floor tiles, painted or printed decorations, and so forth, were subject to copyright registration" under the Office's post-*Mazer* regulations and policies. *1975 Register's Report Hearing* 1857. Court decisions reached the same conclusion. *See* p. 6, *supra*.

Congress embraced this prevailing law when it enacted the 1976 Act, adopting language from the Copyright Office's regulations to "draw as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design." House Report 54-55. Moreover, the legislative history confirms that members of Congress were attuned to, and endorsed, the Office's prior treatment of two-dimensional artwork. The House Report explained that "[a] two-dimensional painting, drawing, or graphic work" would receive protection under the Act's definition of PGS works because such a two-dimensional work "is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers and the like." *Id.* at 55.

By adopting language from agency regulations with a well-known, "settled . meaning," Congress "incorporate[d]" into the Act the "administrative and judicial interpretation[] as well." *Bragdon v. Abbott*, 524 U.S. 624, 645 (1998). Under this interpretation,

two-dimensional artwork appearing on a useful article is eligible for protection as a PGS work.

D. The Same Rule Governs Two-Dimensional Artwork On Clothing And Two-Dimensional Artwork On Any Other Useful Article.

The protection afforded to two-dimensional artwork applies fully to two-dimensional designs that are incorporated onto clothing. Indeed, Copyright Office policy after *Mazer* specifically identified "work[s] of art embodied in a textile fabric" as protectable. 57 U.S. Copyright Office Ann. Rep. Reg. Copyrights 6 (1955). And members of the Congress that enacted the 1976 Act pointed to two-dimensional art "printed on or applied to . . . textile fabrics" as a clear example of copyright-eligible work. House Report 55. In light of this background, courts and leading commentators have consistently recognized that graphic designs and other artwork appearing on clothing are PGS works that should receive protection if they are original. *See, e.g.*, *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) ("fabric designs, such as the artwork on . . . sweaters" are protectable by copyright); *Folio Impressions, Inc. v. Byer Cal.*, 937 F.2d 759, 762-63 (2d Cir. 1991) ("printed textile[]" designs for imprinting on apparel were protectable); 1 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2A.08[H], at 2A-133, 2A-134 (June 2016) (Nimmer); 2 Patry § 3:151, at 3-485.

Star tries to counter (at 10-11) this established principle by arguing that there is a contrary "longstanding rule that clothes cannot be copyright-

ed." But the proper question is what artwork *on* clothes can be copyrighted. As Patry explains, "[w]hile one frequently encounters statements such as '[a]s a general rule, items of clothing are not entitled to copyright protection,' claims are rarely in the shape of the clothing." 2 Patry § 3:151, at 3-481 (second alteration in original).

It is true that the overall shape of "ladies' dress" (House Report 55) typically cannot be copyrighted, just as the overall "shape of an automobile, airplane, . . . food processor, [or] television set" is not ordinarily copyright-eligible. *Ibid.* That is because a dress's overall shape usually cannot be "identified separately from" or "exist[] independently of" the dress's utilitarian aspects, such as covering the body. 17 U.S.C. § 101.

But separable pictorial, graphic, or sculptural features *on* a dress or other garment—including a two-dimensional graphic design—are not the "overall shape," and they can be copyrighted. *See* 1 Nimmer § 2A.08[H], at 2A-133, 2A-134. Indeed, they may already *be* copyrighted before being applied to fabric, or before the fabric is shaped into a garment. *Cf. Mazer*, 347 U.S. at 218 (deeming irrelevant whether the statue was incorporated into a useful article before or after it was copyrighted). Thus, while the copyright laws usually do not protect the overall design of a garment, "the fashioning of . . fabric into an article of clothing" does not "cancel out the copyright of the design imprinted thereon." Ginsburg, *supra*.

Star admits (at 54) that the owner of a copyright for a painting does not lose her copyright protection if she prints that painting on an article of clothing.

And by repeatedly arguing (at 50-51, 55) that this case does not involve "fabric design," Star seems to concede that such designs are protected. But there is no special statutory subcategory for fabric design. And Star provides no principled reason for limiting copyright protection to paintings or repeated patterns on bolts of fabric (which is how Star defines "fabric design," *id.* at 50). Rather, fabric designs are just one example of the more general principle that original two-dimensional graphic designs appearing on useful articles are eligible for copyright protection.

Thus, for instance, one decision that Star repeatedly cites, *Jovani Fashion Ltd. v. Fiesta Fashions*, 500 Fed. Appx. 42 (2012), *cert. denied*, 133 S. Ct. 1596 (2013), rejected copyright-eligibility precisely because no such fabric design was at issue. The case involved an entire prom dress; the plaintiff had conceded that no "individual elements of the dress (such as the pattern of sequins)" were separately copyrightable, *Jovani Fashion, Ltd. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542, 551 (S.D.N.Y. 2011). So the district court distinguished an earlier Second Circuit decision involving just such individual elements—a squirrel and leaves, appliquéd to sweaters. *Ibid.* (citing *Knitwaves*, 71 F.3d at 999). Those elements, which the court called "a fabric design," "generally *could* be copyrightable in isolation." *Id.* at 551-52.[6]

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[6] *Accord* 1 Nimmer § 2A.08[H], at 2A-133 (defining "fabric design" to include not only repeating patterns on bolts of fabric but also single designs imprinted on garments, "such as a rose petal").

In short, lower courts have regularly held that graphic or sculptural elements of a garment are copyright-eligible.[7] Star's purported no-copyrights-in-clothing rule provides no basis for denying protection to graphic works that would be copyright-eligible if applied to any other surface.

E. The Copyright Office Confirms That The Act Protects Two-Dimensional Artwork On Clothing Just As On Other Useful Articles.

The Copyright Office has not only set out a test for separability, *see* p. 24, *supra*, it has confirmed that under its approach, correctly applied, original two-dimensional designs on useful articles can be registered. The Copyright Office is responsible for administering the copyright registration system, *see* 17 U.S.C. §§ 408-410, and its judgment is entitled to this Court's respect.

For decades, the Office has consistently adhered to the same view of separability. After notice and comment, the Office formally determined that "[a] two-dimensional design applied to the surface of . . . clothing may be registered," even though the clothing itself may not. 56 Fed. Reg. at 56,531. And more generally, the current Compendium lists a number of

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[7] As discussed more fully below, the lower-court decisions Star cites also rest on flawed reasoning, even though some reached the right result. *Jovani*, for instance, incorrectly treated a garment's aesthetics as a utilitarian function, 500 Fed. Appx. at 45, and *Galiano v. Harrah's Operating Company*, 416 F.3d 411 (5th Cir. 2005), wrongly thought that copyright-eligibility turns on whether the claimed design elements would attract customers once separated from the clothing, *id.* at 420-22.

relevant examples of two-dimensional works that remain copyright-eligible even when applied to useful articles: "[a]rtwork printed on a t-shirt, beach towel, or carpet," "[a] colorful pattern decorating the surface of a shopping bag," and "[a] drawing on the surface of wallpaper." Compendium III § 924.2, at 900:40-41. Thousands of works have been registered based on the Office's longstanding interpretation.

At a minimum, the Copyright Office's longstanding, expert judgment that two-dimensional designs on useful articles can be registered "warrant[s] respect." *Alaska Dep't of Envtl. Conservation v. EPA*, 540 U.S. 461, 487-88 (2004) (quotation marks and citation omitted); *see also Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 286 & n.5 (3d Cir. 2004) (en banc) (Alito, J.) (deferring to the "longstanding practice" of the Copyright Office on a question of copyright-eligibility); *Inhale, Inc. v. Starbuzz*, 755 F.3d 1038, 1042 (9th Cir.) (deferring to the Copyright Office's approach to conceptual separability as set forth in the Compendium), *cert. denied*, 135 S. Ct. 758 (2014).[8]

II. The Contrary Proposals From Star And Its Amici Are Flawed.

Star's alternative approach to separability should be rejected. Though Star premised its petition for certiorari on a supposed need for clarity (Pet. for

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[8] This Court declined to review the second question presented in Star's petition, concerning the level of deference owed to individual registration decisions by the Copyright Office. *See* Pet. for Cert. i; 136 S. Ct. 1823 (2016). That issue is distinct from whether deference is due to the Copyright Office's consistent reading and application of the statute.

Cert. 12), Star now mixes and matches various lower-court approaches to create a new multi-part test that would merely sow confusion. Worse, the two conceptual-separability tests that Star borrows have no foundation in the Copyright Act, which may explain why they have been rejected by some of Star's *own amici* (as well as *all* the amici who filed in support of neither party).[9]

Star tries to further limit protection for applied art by dramatically expanding what qualifies as a "utilitarian aspect" of a "useful article" to include identification and merely looking attractive—an approach that contradicts both the plain meaning of the statutory term "utilitarian" and the linked statutory definition of "useful article." Finally, Star tries to introduce a novel "presumption" against separability that has no support in the statute or any cited case.

The only clear consequence of Star's approach is that it would under-protect applied art. None of the policy arguments that Star puts forward justifies adopting what *Star itself calls* "undoubtedly . a sub-optimal prophylactic rule" that fails to protect "features one would expect are copyrightable." Star Br. 39 (quotation marks and citation omitted).

A. Star's Multi-Part Separability Test Is Inconsistent With The Statute And Would Under-Protect Applied Art.

As Star observes (at 30-31), section 101's separability test has two related parts: (1) it must be possible to "identif[y]" a PGS feature "separately from" the

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[9] *See* Intellectual Prop. Prof. Br. 22-23, 25; AIPLA Br. 11-15; NYIPLA Br. 20, 22; IPLA of Chicago Br. 16-17.

article's "utilitarian aspects," and (2) the feature must be "capable of existing independently of" those same "utilitarian aspects." 17 U.S.C. § 101. Star argues that these requirements impose an impenetrable seal between art and function: according to Star, if a feature "is even slightly utilitarian or both utilitarian and artistic, it cannot be copyrighted." Star Br. 31; *see id.* at 38. But *nothing* in the text supports that pure-art concept. Indeed, Star's theory is fundamentally inconsistent with a statute that protects "applied art," 17 U.S.C. § 101, which is by definition art that, in contrast to fine art, has practical, utilitarian elements. *See* p. 20, *supra*.

1. Star does not place significant weight on the "identified separately" requirement, acknowledging (at 32) that it is "often easy" to satisfy. That is correct, because this prong "simply requires that when you look at a useful article, you must be able to discern pictorial, graphic, or sculptural features." 2 Patry § 3:146, at 3-475.

But Star still tries to add an additional, atextual requirement to its test by suggesting that a feature is separately identifiable only if it is "purely artistic." Star Br. 38. The statute does not include this requirement, and it is inconsistent with *Mazer*. The statuette there was identifiable separately from the utilitarian aspects of a lamp, but it was not *purely* artistic because it served as the "base[] for table lamps, with electric wiring, sockets and lamp shades attached." 347 U.S. at 202. The sculpture thus surely was at least "slightly utilitarian," Star Br. 31. But that had nothing to do with whether it was a "separately identifiable" "pictorial, graphic, or sculptural feature[]."

2. More central to Star's argument is its construction of the "capable of existing independently" prong of section 101. Star admits (at 33) that this part of its test is "more challenging" for courts to apply, and it ultimately concocts a brand-new test that incorporates at least "three distinct approaches." The result is both indistinct and incorrect.

As an initial matter, Star claims (at 33, 38) that the Copyright Office follows the same approach to conceptual separability. But Star's hybrid bears no resemblance to the Copyright Office's "side-by-side" test, *see* p. 24, *supra*. Contrary to Star, the Copyright Office does not require strict separation between aesthetics and utility—an unworkable standard that would ask the Office (and courts) to play "the role of art theorist[]." Intellectual Prop. Prof. Br. 22. A copyright applicant can register the carving on the back of a chair without having to prove that the carving derives *none* of its aesthetic value from appearing on the chair. *See* Compendium III, § 924.2(B), at 900:40. Similarly, a copyright applicant for the design of a lamp with a statuette base does not lose its protection if the statuette—by holding up the lamp—"advance[s] the utility of the article" somewhat. Star Br. 33, 38.

Star's proposed combination of tests therefore would upend the decades-old Copyright Office practice on which countless registrations rest. Worse still, the conceptual-separability tests that Star offers as ingredients in its blend ("design process" and "likelihood of marketability") are inconsistent with the Act's text, history, and purpose.

a. *Design-process.* According to Star, the design-process test asks whether design features "reflect[]

the designer's artistic judgment exercised independently of functional influence." Star Br. 34 (quoting *Pivot Point Int'l v. Charlene Prods, Inc.*, 372 F.3d 913, 931 (7th Cir. 2004) (emphasis omitted)). That test lacks any textual basis at all. As Star seems to concede (at 40), section 101's definition of a PGS work "looks to the useful article as it exists, not to how it was created." *Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting). Yet the design-process approach does the opposite: instead of asking whether the artistic features are hypothetically "capable of existing" independently of an article's utilitarian aspects, 17 U.S.C. § 101, it asks whether, as a matter of historical fact, the designer was influenced more by aesthetics than by function. Thus, that test could easily consider two identical works of art and produce two different answers, depending on the two authors' state of mind. That bears no resemblance to what Congress adopted.

Star suggests (at 40) that the design-process test is nonetheless appropriate because it screens out works of industrial design, which Congress did not want to receive copyright protection. Star observes that "[i]ndustrial design is dominated by the merger of aesthetic and utilitarian concerns," and thus argues that protection should be reserved for works "whose form and appearance reflect the unconstrained perspective of the artist." *Ibid.* (quotation marks and citation omitted). This test is implausibly narrow, because it provides no way to distinguish between industrial design and applied art. No less than industrial designers, "designers of applied art create with functional limitations in mind." 2 Patry § 3:141, at 3-433. Indeed, the artist's interest in function helps to distinguish "applied art" from "fine

art." *See* pp. 20-21, *supra*. Congress elected to provide copyright protection to *both* fine art and applied art, but the design-process test envisioned by Star privileges the former.

Star's version of the design-process test is also at odds with the Copyright Act's history. *First*, the test would likely produce the wrong result under the facts of *Mazer*. The lamp bases there did not emerge from the designer's "'unconstrained perspective,'" Star Br. 40 (citation omitted); the copyright applicant always "intended primarily to use the statuettes in the form of lamp bases." *Mazer*, 347 U.S. at 204-05 (quotation marks omitted). But this Court held that the statuette was eligible for copyright notwithstanding the designer's intent. *Id.* at 205.

Second, the design-process approach would effectively reinstate the discredited test from the Copyright Office's 1956 regulations, which denied protection to designs that were "necessarily responsive to[] the requirements of [the article's] utilitarian function." 37 C.F.R. § 202.10(c) (1956). The Copyright Office quickly discarded this requirement when it amended its regulations in 1959, *see* pp. 4-5, *supra*. When it enacted the Copyright Act and incorporated language from the 1959 regulation, there is no evidence Congress intended to revive it.

Third, Congress's intent was to create a "clear," more objective standard, not a more subjective one. House Report 55. Even if a design is "determined by esthetic (as opposed to functional) considerations" in its designer's mind, it still is not copyright-eligible if it cannot hypothetically be separated from the useful functions of the article on which it appears. *Ibid.* Conversely, if the pictorial, graphic, or sculptural

features objectively *can* be separated from the useful functions, it does not matter whether the designer was thinking purely aesthetic thoughts.

To the extent design-process is relevant to separability, it is only in a narrow evidentiary sense. *Accord* Pet. App. 40a (reasoning that design-process is not dispositive but that a designer's testimony may offer relevant "clues"). If, for example, a designer can establish that her design of an artistic feature was not constrained in any way by functional concerns, that will support the argument that the feature is capable of existing independently from the article's utilitarian aspects. But ultimately, the statute's focus is on the design, not its conception.

b. *Marketability.* Under the "likelihood of marketability" approach, courts would ask whether "'there is substantial likelihood'" that the claimed PGS feature "'would still be marketable to some significant segment of the community' without its utilitarian function." Star Br. 35 (quoting *Galiano*, 416 F.3d at 419 (emphasis omitted)). This "completely extrastatutory" test has faced heavy criticism. 2 Patry § 3:143, at 3-439, 3-440 n.5 (calling the test "discredited" and "the worst possible solution" to conceptual separability). Even the one circuit that endorsed the test (the Fifth) described it as "suboptimal" and therefore adopted it for "garment design only"—a wholly arbitrary distinction. *Galiano*, 416 F.3d at 421-22 & n.27 (emphasis omitted). The criticisms of this approach are well founded, and this

Court should reject it as "strange" to copyright law. 1 Nimmer § 2A.08[B][4], at 2A-76.[10]

This Court long ago held that copyright protection does not turn on an Article III judge's personal taste in art. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."). As the Court explained in *Mazer*, "[i]ndividual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art" to guide whether works should receive copyright protection. 347 U.S. at 214; *accord* House Report 54 (noting that the Act contains "no implied criterion of artistic taste"). Thus, an author is entitled to copyright protection if her work is original and it falls within an enumerated category of authorship. 17 U.S.C. § 102(a). An author is not *also* required to show that there is a market for her expression. A teenager's diary and the latest Harry Potter novel are entitled to the same protection.

The likelihood-of-marketability approach contradicts these settled principles. It would make copyright protection for PGS features on useful articles turn on their perceived prospects for immediate commercial success, even though mass appeal is not

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[10] Star refers (at 42) to the likelihood-of-marketability approach as "*Nimmer*'s approach," but Professor Nimmer's treatise simply describes the test without endorsing it. Indeed, after noting possible arguments in favor, the treatise acknowledges that the approach also "can be critiqued as (1) strange to copyright; (2) liable to unduly favor more conventional forms of art; and (3) simply too restrictive." 1 Nimmer § 2A.08[B][4], at 2A-76, 2A-77.

a requirement for *any* other type of work. Moreover, by requiring judges to make subjective, predictive judgments about whether there is a "substantial likelihood" that a work will find a market with "some significant segment of the community" (Star Br. 35), the test inevitably privileges "popular art" over more unfamiliar art forms. *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 422 (2d Cir. 1985) (Newman, J., dissenting); *accord* Pet. App. 41a; AIPLA Br. 14-15. Justice Holmes's opinion for the Court in *Bleistein* cautioned against just this possibility: making perceived artistic value the benchmark for protection would mean that "some works of genius would be sure to miss appreciation" from judges who are not well positioned to predict future artistic trends. 188 U.S. at 251.

Acknowledging these "fair criticisms," Star argues (at 41-42) that marketability is just a proxy for independence. But a viewer can mentally separate artistic work from functionality (all the statute requires) without also wanting to *buy* the work. Unpopular applied art is still applied art.

Star also contends (at 36) that *Mazer* supports this test, but the opposite is true. The Court noted in *Mazer* that sales of the statuette "in lamp form accounted for all but an insignificant part of respondent's sales," 347 U.S. at 203. It therefore is puzzling that Star cites this passage for the proposition that the statuette would pass Star's test, *i.e.*, "was marketed to a *substantial* segment of the community." Star Br. 36 (emphasis added). The uncertainty over whether the likelihood-of-marketability test would yield the right result in *Mazer* is another serious mark against it.

Star criticizes (at 42) some other lower courts' approaches as "hopelessly vague, difficult to apply," and entirely "subjective."[11] But Star's approach shares the same vices, and should be rejected for the same reasons.

B. Star's Definition Of A "Utilitarian" Aspect Of A "Useful Article" Is Contrary To The Statute's Plain Meaning.

Star tries to further limit copyright protection by pairing its narrow approach to separability with an expansive understanding of the "utilitarian aspects" of a "useful article." 17 U.S.C. § 101. Star's theory of the "utilitarian aspects" of a cheerleading uniform was rejected below (Pet. App. 43a-45a), but Star did not include it in the question presented, which focused on when a design is separable, not on what it is separable *from*. *See* Pet. for Cert. i; *Wood v. Allen*, 558 U.S. 290, 304 (2010). Star's arguments are incorrect in any event.

Star contends (at 32, 45, 53, 55) that the "utilitarian" aspects of clothing designs include a garment's capacity to convey information (*e.g.*, by identifying the wearer of a cheerleading uniform as a member of a team) and to make the wearer appear more attractive (*e.g.*, by "drawing attention to certain parts of the wearer's body," or "creat[ing] a slimming effect"). Star's contention that decorative and expressive

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[11] Star is correct to criticize the so-called "primary-subsidiary" approach (not applied in this case) on these grounds. Asking whether a design's artistic features are "primary" and its utilitarian aspects are "secondary" has no grounding in the statute and requires courts to make purely subjective judgments. *See Carol Barnhart*, 773 F.2d at 421 (Newman, J., dissenting).

functions like these are *utilitarian* functions is contrary to the plain text of the statute and would deny protection to designs that are uncontroversially copyrightable.

1. a. The question whether a PGS feature is separable from a useful article's utilitarian aspects should be evaluated by reference to what makes the article "useful" in the first place. An article is "useful" if it has "an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. Because portraying an article's appearance or conveying information are not functions that make an article useful, they are not among the useful article's "utilitarian aspects." *Accord Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 329 n.3 (2d Cir. 2005). The ordinary meaning of "utilitarian" further supports this straightforward reading. As noted, p. 21, *supra*, "utilitarian" is *the opposite* of decorative, beautiful, or ornamental. "Utilitarian features" are by definition "practical," *not* expressive or aesthetic. *Ibid.*

Taken together, the statutory definition of "useful article" and the ordinary meaning of "utilitarian" make clear that an article's expressive and decorative functions—whether conveying information or enhancing appearance—are not *utilitarian* functions. As a result, PGS features do not have to be separable from these "functions" to receive protection. This understanding brings the separability inquiry in line within overall copyright policy, because "the 'function' of decoration [is] precisely what is ordinarily conceived of as protected by copyright." Shira Perlmutter, *Conceptual Separability and Copyright in*

the Designs of Useful Articles, 37 J. Copyright Soc'y U.S.A. 339, 370 (1990).

b. Resisting this conclusion, Star relies (at 53) on the term "merely" in the definition of "useful article." Star argues that "portraying appearances" and "conveying information" *are* "utilitarian functions"—they are just not enough standing alone to make an article a useful article. That misreads the statute.

The Act contains only one concept of utility: the "utilitarian aspects" of a "useful article" (in the "PGS work" definition) are the same utilitarian aspects that can *make* the article a useful article (in the "useful article" definition). And a function that is "merely" "portraying" or "identifying" is excluded from the definition of "utilitarian function." Once excluded, that function ceases to be relevant to separability. Whether the useful article has *other* functions is irrelevant: the word "merely" is used in the exclusion, *not* in counting how many functions a useful article has.

c. The correct approach can be illustrated by using clothing as an example. Clothing is a useful article because it has the intrinsic utilitarian function of covering the body to provide warmth and preserve modesty, even though it also has non-utilitarian, decorative functions. But the fact that clothing is a useful article does not change the fact that mere decoration is not a utilitarian function (whether of clothing or paintings). And a PGS feature need not be separable from the *non*-utilitarian aspects of clothing to receive protection. This distinction explains why costumes are typically useful articles but masks are not. *See* 56 Fed. Reg. at 56,531-32. Costumes and masks have similar decorative and identifying func-

tions, but costumes also serve the "useful function" of "clothing the body." *Id.* at 56,532. PGS features must be separable from *that* function to receive protection—a condition that "two-dimensional design[s] applied to the surface" of costumes satisfy, but designs of the costume's overall shape generally do not. *Ibid.*

2. Star's broad understanding of a useful article's "utilitarian aspect[s]" is also flawed because it would deny protection in paradigm cases. For instance, the Copyright Office Compendium recognizes that "[a]rtwork printed on a t-shirt" is eligible for protection (Compendium III § 924.2, at 900:40)—an example that mirrors the House Report's examples of protectable "two-dimensional painting[s], drawing[s], or graphic work[s]" "applied to . . . textile fabrics," House Report 55. Star strains (at 54-55) to distinguish the t-shirt example, but it fails to explain why a picture on a t-shirt does not serve the "functions" of drawing the viewer's attention to the picture and improving the wearer's appearance. *Why else* would artwork appear on a t-shirt, if not to enhance appearance?

Artwork printed on a t-shirt may also serve an "identification" function, as Star articulates that concept. Consider, for example, a t-shirt with a sports team's logo on the front, which identifies the wearer as a fan of the team. Under Star's definition of "utilitarian," the logo would lose copyright protection when used in this way, because the design cannot be separated from its "function" of identifying the wearer as a fan. But it could still be copyrighted if painted onto a canvas and hung on the wall. That result is manifestly contrary to the statute, which gives a

copyright holder the right to reproduce a pictorial or graphic work "in or on any kind of article." 17 U.S.C. § 113(a).

The only amicus brief supporting Star's "expressive functionality" theory reveals the theory's remarkable (and problematic) implications. The brief argues that because a designer's choice of "fabric prints" can "influence people's perceptions of the wearer," two-dimensional fabric designs "will often be utilitarian in nature"; therefore, the brief argues, the numerous "courts and scholars [who] have often reflexively" concluded the opposite are all wrong. Br. of Profs. Buccafusco & Fromer 8, 18.

Understandably, Star does not endorse the extreme proposal of its amicus, which is inconsistent with both decades of Copyright Office practice and several examples used in the House Report. *See* pp. 29-30, *supra* (discussing Star's attempt to distinguish pattern designs). But this result is the clear logical endpoint of Star's theory.

C. There Is No Presumption Against Separability.

There is no support in the text, structure, or history of the Copyright Act for Star's novel "presumption" against separability (at 27-29, 38-39, 43)—a presumption that apparently no court has ever applied. Courts should faithfully apply the statute's test for whether an artistic feature is separable without placing a thumb on the scale for or against copyright protection.

1. To support its presumption, Star points (at 27) to the fact that designs of useful articles are eligible

for protection as PGS works "if, and only to the extent that," the designs incorporate separable PGS features. 17 U.S.C. § 101. This provision simply establishes the conditions under which designs of useful articles receive protection: "if" certain conditions are met, PGS features are protected, "to [a certain] extent." That hardly amounts to a directive to presume that the conditions are *not* met.[12]

2. Reaching beyond the text, Star argues (at 28-29, 43) that a presumption against separability is appropriate because it implements Congress's intent to deny copyright protection to industrial designs. But Congress also intended to *grant* protection to "applied art," including "design[s] of useful article[s]" that include separable features. 17 U.S.C. § 101. The key question is how to distinguish between the "industrial designs" and "applied art," and the answer cannot turn on arbitrary presumptions. There is no principled reason to limit the protection that Congress made available for applied art to make double-sure that industrial designs are not registered. Indeed, one could just as easily argue that courts should apply a presumption *in favor* of separability in order to ensure that applied art is protected.

3. Finally, Star cites (at 39) a decision by this Court involving trade-dress protection. Notably, however, the issue in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000), concerned only

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[12] At the certiorari stage, Star identified an entirely different part of the text as the supposed source of its presumption, but it has now abandoned that argument. *See* Pet. for Cert. 20 (purporting to derive a presumption from the definition of "useful article").

what level of *proof* is required to establish trade-dress protection. Thus, the Court indicated that, in "close cases," courts should require proof of "secondary meaning" associated with a product's presentation, rather than allowing a company to rely on the "inherent[] distinctiveness" of its product. *Id.* at 215. That is not a presumption *against trade-dress protection*, just a rule of proof. Here, by contrast, a presumption against separability would *entirely* deprive original works of copyright protection—protection that falls within the terms of the congressional grant. Congress's decision not to adopt an industrial-design statute does not justify applying an anti-intellectual-property policy to the copyright statute Congress *did* enact.

D. Policy Considerations Do Not Support Star's Narrow Approach To Separability.

Star acknowledges that its approach to copyright protection "undoubtedly" results in "a sub-optimal prophylactic rule." Star Br. 39 (quotation marks omitted). But Star does not discuss the costs of under-protecting original, copyright-eligible works. As the Court explained in *Mazer*, "[t]he economic philosophy behind the clause empowering Congress to grant . . . copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors." 347 U.S. at 219. Permitting others to copy separable artistic designs would reduce the economic incentive to innovate, because authors know that knockoffs will capture much of the reward.

Star downplays (at 39) the costs of an approach to copyright-eligibility that denies protection to designs "one would expect are copyrightable." But Congress decided to protect applied art no less than "fine" or "pure" art, and this Court should respect Congress's "policy judgment." *Eldred v. Ashcroft*, 537 U.S. 186, 208 (2003).

On the other side, Star puts forward several arguments for limiting the copyright protection available for applied art. But Star's concerns do not withstand scrutiny. They certainly do not provide a basis for departing from the most natural reading of the Copyright Act.

1. Star suggests (at 24-25, 30) that protection for the designs of useful articles should be "channeled" to other intellectual-property regimes, and in particular to design patents. Thus, despite grudgingly conceding (at 25) that "overlap between copyright and design patents may be inevitable," Star appears to argue that design-patent law should largely displace copyright protection in this area. But this Court held in *Mazer* that the potential for overlap between copyright and patent law is *irrelevant*, because "[n]either the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted." 347 U.S. at 216.[13] Congress endorsed this approach when it codified *Mazer*. *See* House Report 54 ("[W]orks of 'applied art' encompass all original [PGS] works that are intended to be or have been

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[13] Other intellectual-property regimes overlap as well. *See J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 144 (2001) (utility patents and special statutory protections for plants); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484 (1974) (patents and trade secrets).

embodied in useful articles, regardless of factors such as . . . the potential availability of design patent protection.").[14]

2. Star also relies on congressional inaction, arguing (at 11, 22, 26, 27-29, 43) that Congress's decision not to pass legislation protecting industrial designs (and fashion designs in particular) weighs against copyright protection. "[F]ailed legislative proposals" are always "dangerous ground" to rely on when interpreting a statute. *Solid Waste Agency of N. Cook Cnty. v. U.S. Army Corps of Eng'rs*, 531 U.S. 159, 169-70 (2001) (citation omitted). They are particularly unilluminating here, because the legislative proposals have involved efforts to extend protection to the three-dimensional designs of useful articles *as a whole*, such as the overall shape of a dress.[15] Such proposals do not support any negative inferences about the copyright protection available for the separable artistic features of useful articles, including two-dimensional designs that appear on clothing.

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[14] The Copyright Office likewise agrees that "if a work otherwise meets the requirements of copyrightability, it should not be denied [registration] simply because the claimant happens to be entitled to supplementary protection under other legislation." Registrability of Pictorial, Graphic, or Sculptural Works Where a Design Patent Has Been Issued, 60 Fed. Reg. 15,605, 15,606 (1995) (abolishing requirement to elect either design patent or copyright).

[15] *See* p. 9, *supra* (describing Title II of the Senate's copyright bill); *see also* H.R. 5055, 109th Cong. § 1(a)(2) (2006) (proposed bill to provide limited protection for "fashion design," which was defined as "the appearance *as a whole* of an article of apparel, including its ornamentation" (emphasis added)). Those proposals also consistently disclaimed any effect on existing rights under copyright law). H.R. 5055, 109th Cong. § 1(h); p. 9, *supra*.

Similarly, that Congress decided to give specific protection to the overall shape and layout of boat hulls and to three-dimensional patterns in semiconductor chips, *see* Star Br. 29 (citing 17 U.S.C. §§ 901-914, 1301-1332), does not suggest that Congress impliedly repealed the existing protection for separable artistic features of useful articles.

3. Finally, Star suggests (at 6, 22, 39, 50, 57), that unless courts construe section 101's separability provision narrowly, designers will use copyright protection to create monopolies and thwart competition. This concern is unfounded.[16]

First, Star's argument overlooks that separability is only a *necessary* condition for copyright protection; an author must also show that her PGS work is "original." 17 U.S.C. § 102(a); *see also Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345-47 (1991) (explaining that "originality" is "the touchstone of copyright protection").

Second, and relatedly, an author asserting infringement must prove "substantial similarity" to the copyrighted work. 4 Nimmer § 13.01[B], at 13-10.1. That requirement refutes any contention that a single graphic design could lock up an entire market segment. Thus, in this case, Varsity did not receive a copyright for a single shape, but rather for "the treatment and arrangement" of shapes and patterns "coupled with their coloring." J.A. 66, 316, 322. Other designers thus could use the same building

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[16] Star's insinuation (at 6, 13) that Varsity has a monopoly and has engaged in anticompetitive conduct has no record support. In fact, the district court dismissed Star's Sherman Act counterclaim, J.A. 164-68, and Star did not cross-appeal.

blocks of shapes, chevrons, and stripes, provided they did not copy Varsity's particular selection and arrangement.

Third, "[t]he limited scope of the copyright holder's statutory monopoly" ensures a proper "balance" between the need to "encourage[] and reward[]" artistic creation and the importance of preserving the public domain. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). "Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself." *Mazer*, 347 U.S. at 217. Thus, in contrast to patents, copyrights provide no protection against a rival that independently creates a substantially similar work. Copyrights prevent only *copying* the original elements. *See Feist*, 499 U.S. at 361. That requires proof of copying, or at least access to the copyrighted work.

Each of these requirements protects legitimate competition while prohibiting piracy. Copyright protection for applied art "assures authors the right to original expression, but encourages others to build freely upon the idea and information conveyed by a work." *Feist*, 499 U.S. at 349-50 (citation omitted).

III. Varsity's Two-Dimensional Graphic Designs Are Copyright-Eligible PGS Works.

Varsity's two-dimensional graphic designs are copyright-eligible PGS works, just like the examples of two-dimensional artwork identified in the House Report and the Copyright Office's Compendium. To the extent Varsity's designs qualify as the "designs of useful articles" at all, they are clearly separable from the utilitarian aspects of cheerleading uniforms.

Star's arguments to the contrary are both legally and factually flawed. Moreover, even if Star's flawed design-process and marketability tests were adopted, the Court should affirm.

A. Varsity's Designs Are Copyright-Eligible Under The Correct Statutory Approach.

1. As a threshold matter, Varsity's graphic designs are not "designs of useful article[s]." 17 U.S.C. § 101; *see also* Br. in Opp. 26 (making this argument); Varsity C.A. Br. 33 (same). Rather, they are two-dimensional graphic designs that appear *on* useful articles. Therefore, they are PGS works without any need for separability analysis. *Accord* 2 Patry § 3:151, at 3-485 (advocating for that result in this case); Ginsburg, *supra* (same).

Star argues in passing (at 44) that "the arrangement of color blocks and stripes" is itself a useful article.[17] But Star does not explain what "utilitarian function" this graphic design serves except to "portray the appearance of the article or to convey information," and under the statutory definition of "useful article," those expressive functions do not qualify as utilitarian. 17 U.S.C. § 101; *see* Part II.B, *supra*.

2. Even if Varsity's graphic designs are "designs of useful articles," they are easily separable from the utilitarian aspects of cheerleading uniforms and thus are copyright-eligible PGS works. Just like other

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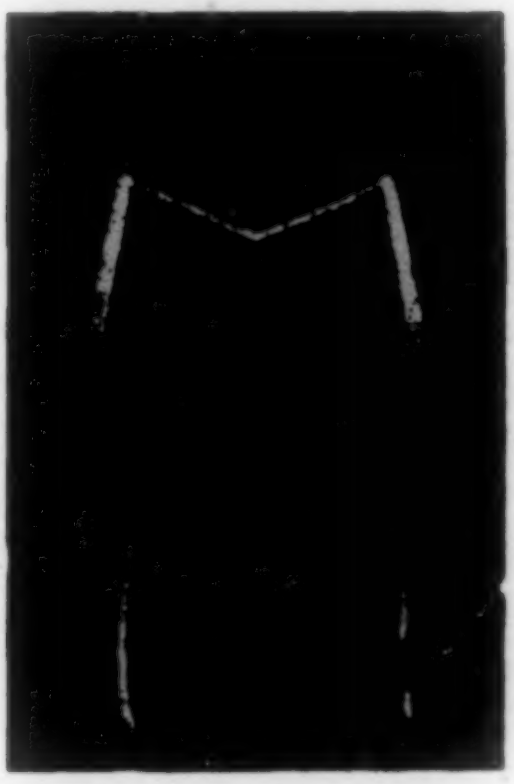
[17] The court of appeals tersely stated that Varsity's copyrighted works were the design of the garments, Pet. App. 42a, but it overlooked that the copyrights are only in two-dimensional elements like colors and chevrons, not crop tops and skirts. *See* pp. 59-60, *infra*.

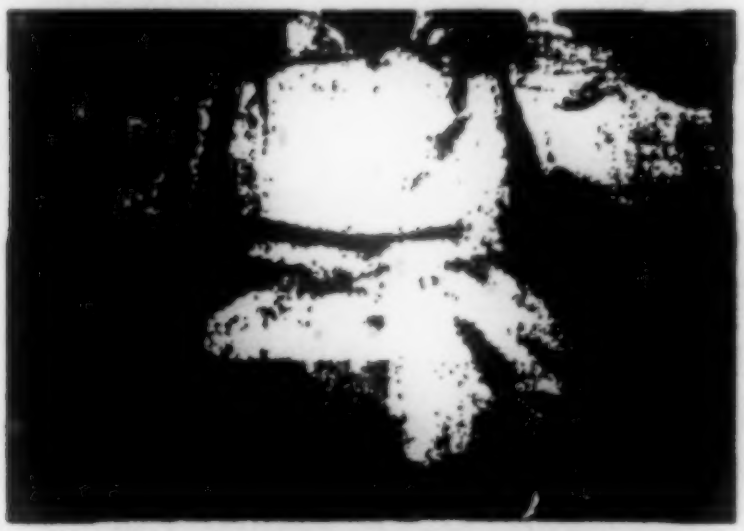
two-dimensional artwork printed on clothing, Varsity's graphic designs can be identified separately from the uniform and its utilitarian functions of covering the body while wicking away moisture and permitting the wearer to "cheer, jump, kick, and flip." Pet. App. 42a-43a, 45a. In addition, the designs are capable of existing independently of the utilitarian aspects of the uniforms; in fact, they have been reproduced on other apparel including cheerleading warm-ups and jackets. *See* J.A. 261, 273-79. For example, the pictures below show Design 0815, as depicted in the deposit materials (on the left) and as reproduced on a warm-up and a jacket (on the right):



J.A. 213, 274, 276. The design could also be placed on other useful articles, such as bags, notebooks, or

even iPhone covers. J.A. 248. Or it could simply be a two-dimensional graphic work. *See* J.A. 270.

Moreover, to the extent it is relevant, cheerleading uniforms can exist without Varsity's two-dimensional designs on their surface. Indeed, Varsity has produced cheerleading uniforms without any decoration:



J.A. 272. Thus, Varsity's graphic designs satisfy the Copyright Office's test because the design and the useful article on which they appear (cheerleading uniforms) could exist side-by-side. *See* Compendium III § 924.2(B), at 900:40.

B. Star's Contrary Arguments Are Meritless.

Star's contention that Varsity's two-dimensional graphic designs are ineligible for copyright protection is meritless. Several of Star's arguments depend on its flawed tests for separability and its misunderstanding of what qualifies as a "utilitarian aspect" of a "useful article." Star's remaining arguments are inconsistent with the factual record and with Copyright Office policies for submitting deposit materials.

1. As its lead argument, Star contends (at 44-48) that Varsity's graphic designs are not separable from cheerleading uniforms on which they appear because the designs are intrinsically connected with the idea of "cheerleading-uniform-ness" and help to identify cheerleaders as cheerleaders.[18] Thus, Star argues (at 48) that even if the selection and arrangement of stripes, chevrons, and color blocks were depicted on a different medium, the design would still "shout 'cheerleading uniform.'" Similarly, Star discounts the fact that an identical athletic garment can be produced without any graphic design, on the theory that plain white uniforms would not be "appropriate attire for a member of a cheerleading squad." *Id.* at 45 (quoting Pet. App. 53a). Star also asserts that the graphic designs are inseparable from the utilitarian aspects of the uniforms because the designs help "bring . together" the different pieces of the uniform and "draw[]" an observer's "attention." *Id.* at 47.

These contentions perfectly illustrate the problems with treating identification and expressive functions as "utilitarian." Whether a plain white uniform is *really* "appropriate" cheerleading attire, and whether certain shapes and color patterns are needed to "bring" an outfit "together," are questions better answered by fashion critics or philosophers than by Article III courts. *Cf.* Pet. App. 58a (district court decision invoking Plato's *Republic* when defining "the essence of a 'cheerleading uniform'"). Such impondera-

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[18] Again, case-specific arguments about what utilitarian functions a cheerleading uniform serves are not within the question this Court agreed to decide. *See* p. 41, *supra*.

ble questions are not relevant under the proper reading of the statute. *See* Part II.B, *supra*.

In any event, Star's suggestion that the particular patterns of stripes, chevrons, and color blocks used in Varsity's designs are intrinsic to any true cheerleading uniform is demonstrably false. There is no single ideal of "cheerleading-uniform-ness" that has been fixed throughout time. Styles evolve, and patterns that are popular today did not adorn uniforms from time immemorial. Consider this example, featuring cheerleaders at Trinity University in San Antonio, Texas in 1936:

Mary Ellen Hanson, *Go! Fight! Win!: Cheerleading in American Culture* (1995) (pictorial insert). Or consider this example, depicting University of Denver cheerleaders from 1965:

Ibid. Or this 1950s photo, featuring cheerleaders from Southern Methodist University clad in plain-white garments:

Doris Valliant, *History of Cheerleading* 17 (2003). All of these are pictures of cheerleaders. None of the uniforms depicted have the stripes, chevrons, or color blocks that Star claims (at 46) are essential "to cause an observer to perceive the wearer as a cheerleader." Star provides no reason why artistic features commonly used today should define "cheerleading-uniform-ness" (rather than the design trends of either 1950 or 2050).

2. Star argues (at 48-49) that the commercial objectives of Varsity's designers and the supposed practical constraints on their work defeat copyright protection. But for the reasons explained, pp. 3, 20-21, 36-38, *supra*, the commercial origin of applied art does not limit copyright-eligibility, and Star's version of the design-process test should be rejected.

It is also irrelevant that Varsity's designers used the outlines of cheerleading uniforms when creating two-dimensional graphic works. Artists may use different canvases for their work, and a two-dimensional painting sketched to fit, for example, on a label for a wine bottle does not receive less protection than a two-dimensional painting on a canvas. *See* http://www.chateau-mouton-rothschild.com/label-art (last visited Sept. 13, 2016) (collecting original labels painted for Chateau Mouton Rothschild by artists including Marc Chagall, Salvador Dali, and Pablo Picasso).

3. Star also tries to defeat Varsity's copyright protection by creating confusion about the nature of the works that the Copyright Office registered. At times, Star argues (at 49) that Varsity sought protection for the designs of *three*-dimensional cheerleading uniforms. Elsewhere, Star makes (at 51-52) the

contradictory assertion that Varsity received protection only for the drawings and photographs that Varsity submitted to the Copyright Office, rather than for the two-dimensional designs that were depicted *in* those drawings and photographs. Neither characterization is correct.

Star's attempt to limit Varsity's copyright to the sketches and photographs submitted misunderstands the Copyright Office rules for deposit materials. The Office instructs registrants to submit material identifying the separable design features applied to a useful article (such as drawings or photographs) rather than the useful article itself. *See* Compendium III § 1506, at 1500:11; 37 C.F.R. §§ 202.20(c)(2)(xi)(B)(2), 202.21(a). Consistent with these regulations, Varsity's registration statements claimed "fabric design (artwork)" and "2 Dimensional artwork" rather than, for example, "photograph[s]"—an available check-box on the Copyright Office's application form. J.A. 48-50, 57-59.[19] Moreover, correspondence between the Copyright Office and Varsity concerning other, similar graphic designs leaves no doubt that Varsity was seeking to register "the separable artistic or graphic authorship . . found on the surface" of each article of clothing, not the sketch or photograph depicting the graphic artwork. J.A. 66; *see* J.A. 316, 322.

Star's alternative (and inconsistent) suggestion that Varsity registered a three-dimensional design of

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[19] The Copyright Office instructs that the "2-Dimensional artwork" box should be checked if the authorship consists of "2-dimensional artwork applied to useful articles, and designs reproduced on clothing." U.S. Copyright Office, Form VA Instructions, *available at* www.copyright.gov/forms/formva.pdf.

a cheerleading uniform is mistaken. The Copyright Office "will not register a claim in clothing or clothing designs." Compendium III § 924.3(A), at 900:41. Varsity's registrations describe the works as "2 Dimensional artwork" and/or "fabric design (artwork)," not complete, three-dimensional garment designs. J.A. 38-39, 46, 48, 57, 213-15.[20] And as the statute makes clear, a copyright in the "design" of a useful article extends only to the copyrightable "features." 17 U.S.C. § 101. Star alludes (at 16-17, 50-51) to statements that Varsity has made about its registered designs in other contexts, such as in advertisements. But even if Varsity has sometimes been imprecise in describing its copyright claims to customers and competitors, that does not affect the nature of the copyrights that Varsity has registered with the Copyright Office.

4. Finally, Star raises (at 16, 47-48) a fact-bound argument about how Varsity constructed its uniforms. Discussing Varsity's cut-and-sew method, Star contends that Varsity's designs serve a useful function because the stripes and braiding are supposedly used to cover the seams. Star also asserts that the braiding helps to give the uniform its shape, create "style lines," and minimize stretching. *Ibid.* Star's contentions overlook record evidence establishing Varsity's designers are not constrained by concerns about garment construction when creating their two-dimensional designs. *See* pp. 10-11, *supra*.

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[20] Star suggests (at 15) that the Copyright Office referred to Varsity's "works" as "articles of clothing." But as noted above, p. 12, *supra*, the same Copyright Office letter makes clear that registration was based on the "**separable** artistic or graphic authorship on the surface of each" article of clothing, not the overall three-dimensional uniform design. J.A. 66.

Varsity creates its graphic designs first, and then the production staff works with the designs to decide where to place the seams and braiding; there are no preexisting requirements about where the seams and braiding must appear. J.A. 242, 283-84.

More fundamentally, Varsity can and has applied the same graphic designs onto garments using the alternative process of sublimation—in which the stripes are made using ink, not braid, and there are no seams on the front to cover. J.A. 243-44; *see* p. 11, *supra*; J.A. 260, 262-70 (showing examples of sublimated uniforms with the five designs at issue). Star quibbles (at 16) about whether Varsity used sublimation to incorporate these particular designs onto uniforms before this litigation. That is irrelevant because separability is a *hypothetical* inquiry: it asks whether PGS features are "*capable* of existing independently of [] the utilitarian aspects of the [useful] article." 17 U.S.C. § 101 (emphasis added). The undisputed fact that Varsity *can* add the designs at issue to uniforms through sublimation unequivocally demonstrates that they are capable of existing independently of the garment.

C. Varsity Should Prevail Even Under Star's Design-Process And Marketability Approaches.

This Court should affirm the judgment below even if it adopts either (or both) the design-process and likelihood-of-marketability tests that Star proposes. *See* Br. in Opp. 27 (explaining that Varsity's designs are copyright-eligible under all existing tests); Varsity C.A. Br. 33-34 (same).

As to design-process, the record shows that Varsity's design and production process are separate, and Varsity's designers are not constrained by functional concerns about garment construction when creating two-dimensional graphic designs. *See* pp. 10-11, *supra*; J.A. 258-59, 283-84. Because the arrangements of artistic elements in Varsity's designs "reflect the independent, artistic judgment of the designer[s]," *Pivot Point*, 372 F.3d at 931, they are conceptually separable under a design-process approach.

With respect to likelihood of marketability, Varsity's expert explained that the designs have independent commercial value because they can be applied to numerous other commercial goods. J.A. 248. Star's assertion (at 49, 56) that the designs are not marketable is "based not on evidence but on conjecture," Pet. App. 41a (quotation marks and citation omitted). Indeed, the best that Star can do is to argue (at 56) that "there is no reason to think" that Varsity's designs could be marketable to a significant segment of the public. That evidence-free assertion is plainly inadequate, particularly because *Star* had the burden of proving that Varsity designs registered within five years of first publication were invalid. *See* 17 U.S.C. § 410(c); p. 13, *supra*.

* * * * *

Original two-dimensional designs do not lose copyright protection when they are incorporated onto useful articles. Here, Varsity registered two-dimensional graphic designs that appear on cheerleading uniforms, but that can also be incorporated onto other articles. Under the plain text of the Copyright Act and long-established Copyright Office practice, Varsity's designs are separable from the utili-

tarian aspects of cheerleading uniforms and should receive full copyright protection.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

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REPLY BRIEF

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STAR ATHLETICA, L.L.C., *Petitioner*,

v.

VARSITY BRANDS, INC., VARSITY SPIRIT CORPORATION, AND VARSITY SPIRIT FASHIONS & SUPPLIES, INC., *Respondents*.

On Writ Of Certiorari To The United States Court Of Appeals For The Sixth Circuit

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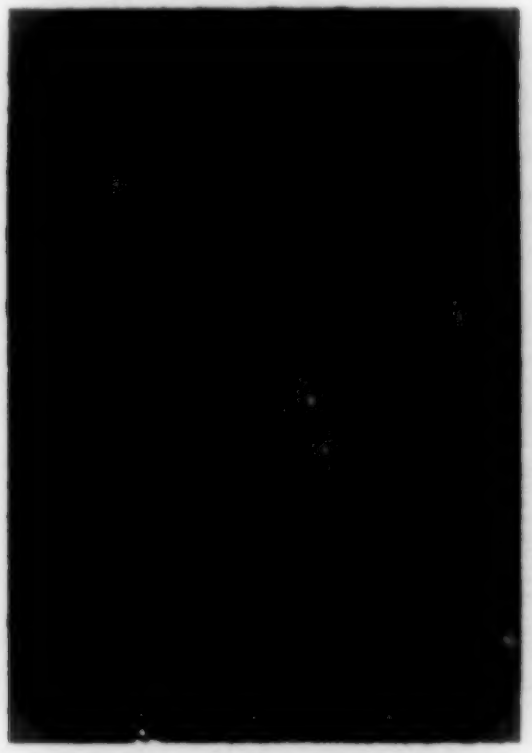
INTRODUCTION

Unlike its position in the lower courts, Varsity now argues that because its cheerleader-uniform designs are two-dimensional, no separability analysis is necessary. Varsity Br. 1–2. That argument assumes two-dimensional designs cannot serve a utilitarian function. They clearly can. Consider a two-dimensional design that serves the utilitarian function of hiding the wearer:



In fact, Congress expressly recognized that two-dimensional pictorial and graphic features incorporated in a useful article can be utilitarian by subjecting *both* types of features to the separability analysis that 17 U.S.C. § 101 requires. Accordingly, Varsity's cheerleader-uniform designs are properly analyzed for separability.

Varsity similarly argues that a garment's pictorial or graphic features can never serve a useful function. Varsity Br. 43–44. Not so. As the Copyright Office recognizes, garments are useful articles that can serve functions in addition to clothing the body. Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,531 (1991) ("Costumes serve a dual purpose of clothing the body *and* portraying their appearance." (emphasis added)). These functions include enhancing the attractiveness of the wearer. The placement of lines on the garment can make the wearer appear shorter and broader or taller and slimmer; other pictorial and graphic features on the garment can draw attention to, or away from, certain body parts. Amici Br. of Profs. Buccafusco & Fromer 18–24, 24–29. Uniforms, in particular, function to identify the wearer as part of a group (the army, healthcare workers, or a cheerleading squad) and portray a unified appearance. And the government concedes that if Star Athletica is correct that the chevrons and stripes on a cheerleader uniform have a utilitarian function, "then Section 113(a) would not protect the application of" those features. U.S. Br. 23; contra U.S. Br. 17–24.

In sum, two-dimensional features of useful articles must still be analyzed to ensure the features are separable. To conduct that analysis, Star Athletica has proposed a separability test that is faithful to the text of Copyright Act § 101 and the Congressional policy against copyright in industrial design, especially garment design. The Court should adopt Star Athletica's test and reject Varsity's invitation to provide a century of copyright protection for cheerleader-uniform designs.

ARGUMENT

I. This case is about separability, not whether two-dimensional works can be copyrighted.

Star Athletica agrees that copyright generally (though not always) protects two-dimensional works. But this case is not about whether two-dimensional works are copyrightable in the abstract. The case is about determining when a two-dimensional design feature is separable from the useful article into which the feature is incorporated. Two-dimensional features are not automatically separable, even if they can be transferred to a variety of media. Contra Varsity Br. 26. This is shown by the Copyright Act's text, the Copyright Office's guidance, and experience.

The Act anticipates that two-dimensional features can be functional. Section 101 says that "pictorial" and "graphic" features must be separable from the "utilitarian aspects of the article" for the design of a useful article to be protectable. 17 U.S.C. § 101. This demonstrates Congress understood that two-dimensional *and* three-dimensional features may be inseparable from the utilitarian aspects of a useful article. Buccafusco & Fromer Amici Br. 19.

Thus, copyright examiners apply a separability analysis to determine if two-dimensional pictorial and graphic features incorporated into the design of useful articles are separable. Contra Varsity Br. 31–32. The Copyright Office recommends that claimants use "[t]he term two-dimensional artwork . . . to describe two-dimensional artwork that has been applied to a useful article," "*provided that* the artwork is . . separable from the useful article." Compendium III § 618.4(C) (emphasis added).

Everyday experience reinforces the point that pictorial or graphic designs can have utilitarian functions. For example, the military holds design patents and trademarks for two-dimensional camouflage designs which, when used on garments, serve a crucial function of concealing soldiers on the battlefield. In addition to camouflage, consider a few more examples:

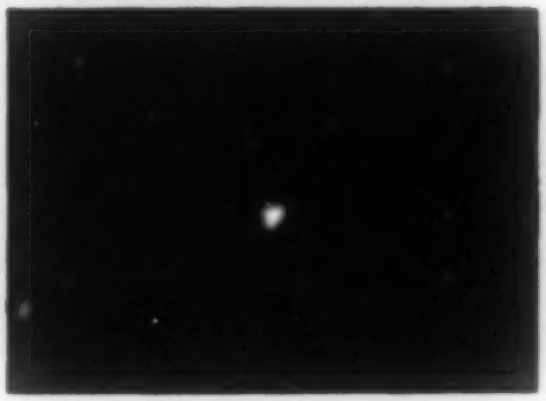
1. Fonts: This brief uses the following two fonts:

AaBbCcDdEeFf

Fonts are two-dimensional and contain elements of creative design. Yet, "because the creative aspects of the character (if any) cannot be separated from the utilitarian nature of that character," fonts are industrial design and cannot be copyrighted. Compendium III § 906.4 (citing 37 C.F.R. § 202.1(a), (e)); *Eltra Corp.* v. *Ringer*, 579 F.2d 294, 298 (4th Cir. 1978).

2. Blank forms: Forms that record information but which do not themselves convey information are not copyrightable because the two-dimensional graphic features are not separable from the form's utilitarian function. See 37 C.F.R. § 202.1(C); *Baker* v. *Selden*, 101 U.S. 99 (1879). This even though a blank baseball scorecard could be framed and hung on the wall, printed on wallpaper, or emblazoned on a notebook cover.

3. Battenburg livery designs: In the United Kingdom, governmental studies concluded that a pattern of large, carefully proportioned two-dimensional designs increases the conspicuity of emergency vehicles. Paul Harrison, *High conspicuity livery for police vehicles* 4 (Police Scientific Dev. Branch, Publ'n No. 14/04, 2004). To the same end, emergency services often add inverted-V chevron designs to the rear of vehicles.



In sum, as a matter of statutory construction, agency application, and practical experience, some two-dimensional pictorial and graphic features are not categorically separable from the useful articles incorporating them, even if two-dimensional features can be transferred to any surface. Accord Profs. Buccafusco & Fromer Br. 14–15.

To support its contrary conclusion, Varsity suggests that the Eleventh Circuit concluded that "it is 'obviously true' that 'any two-dimensional image' is separable from the useful article on which it appears." Varsity Br. 25 (quoting *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1413 (11th Cir. 2015)). But no court, including the Eleventh Circuit, has so supplanted § 101. The Eleventh Circuit merely observed that "nothing (save perhaps good taste)" prevents any two-dimensional image from being "printed, framed, and hung on the wall as art." *Ibid.*

Likewise, Varsity's quotation from Professor Goldstein's treatise, Varsity Br. 25, omits his point that Congress and the courts prevent the use of a copyright in a two-dimensional image to bar the manufacture of a three-dimensional object portrayed therein. 1 Paul Goldstein, *Goldstein on Copyright* § 2.5.3, at 2:83 (3d ed. 2005). Goldstein's analysis actually condemns what Varsity is seeking to do in this very case:

> *Although* it is relatively easy to obtain copyright protection for designs of useful articles appearing in two-dimensional rather than three-dimensional form, *Congress and the courts have limited the rights granted to these works so that copyright control of the two-dimensional work will not confer control over the three-dimensional useful articles made from it.* [*Id.* (emphasis added to language omitted by Varsity).]

Only Professor Patry's treatise supports Varsity's position. And that position is inconsistent with § 101's text and the reality that two-dimensional images can have an intrinsic utilitarian function.

Varsity's new argument is a variation on its argument opposing the petition that this case is about fabric design, not separability. See Varsity Br. 28–31. This is not a case of "two-dimensional designs that are incorporated onto clothing," Varsity Br. 28, but a case of clothing design. Varsity's arrangements of stripes, chevrons, and color blocks are not independent works that happened to be incorporated into cheerleader uniforms. Even when the uniform is removed, Varsity's arrangement of elements still looks exactly like a cheerleader uniform. See IP Profs. Amici Br. in Supp. of Pet'r 17

Until its merits brief in this Court, Varsity saw it the same way, viewing its copyrights as protecting *cheerleading uniform designs*, J.A. 175–86, and threatening competitors for infringing copyrights in "certain garment designs," J.A. 171. As Varsity acknowledges, Varsity Br. 52 n.17, the Sixth Circuit panel majority had no difficulty recognizing that Varsity was claiming copyright in "the designs of cheerleading uniforms and sportswear." Pet. App. 42a. Indeed, when faced with similar claims and similar designs, see Pet. Reply Br. 7–8, the Fifth Circuit similarly recognized that the two-dimensional images at issue there were casino-uniform designs. *Galiano* v. *Harrah's Operating Co.*, 416 F.3d 411, 416–17 (5th Cir. 2005).

The difference between fabric design and garment design is illustrated by one of the fabric-design cases on which Varsity relies, *Folio Impressions, Inc.* v. *Byer California*, 937 F.2d 759 (2d Cir. 1991). Varsity Br. 28. Contrary to Varsity's account, the case did not involve graphic designs on clothing, it involved a design on fabric:

Folio Impressions, Inc. v. *Byer California*, 752 F. Supp. 583, 593 (S.D.N.Y. 1990). And unlike

Varsity's copyrights, Folio's fabric was not designed to follow the contours of the body of the person wearing garments made from the fabric. The placement and design of the roses were unconstrained by functional considerations of garment design.[1]

Varsity buttresses its fabric-design argument by citing the Copyright Office's statement that a two-dimensional design applied to the surface of clothing may be registered. Varsity Br. 31; see also U.S. Br. 9. But Varsity omits clarifying language demonstrating that the Copyright Office is referring to designs printed repeatedly or singly on fabric: "this claim [for a copyright in a two-dimensional design applied to the surface of clothing] *is generally made by the fabric producer rather than the garment or costume designer*. Moreover, this claim to copyright is ordinarily made when the two-dimensional design is applied to the textile fabric and before the garment is cut from the fabric." 56 Fed. Reg. at 56,531 (emphasis added). The Office also identifies its general policy *against* registering copyrights for garment designs, including uniforms. *Id.* at 56,532.

The Copyright Office correctly concludes that only Congress has the authority to extend copyright protection to garment designs. See *ibid.* Indeed, as Varsity's expert witness's *amici* brief acknowledges, this is what European Union member states and other countries have done. Fashion Law Inst. Amici

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[1] Varsity also cites *Knitwaves, Inc.* v. *Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995), as an example of a court recognizing that graphic designs on clothing can be copyrighted. Varsity Br. 28. But the parties there did not dispute that leaf and squirrel designs on sweaters were protectable. 71 F.3d at 1002.

Br. 18. Congress has resolutely resisted that approach for more than a century, and this Court should not legislate a different policy.

II. Star Athletica's approach offers more objective guidance than Varsity's unadorned "side-by-side" analysis.

Star Athletica's approach for the exists-independently prong of the statute proposes three distinct analytical tools—physical separability, design process, and marketability—to aid courts in applying it. Star Br. 33–36, 38. Varsity says Star Athletica's approach "bears no resemblance to the Copyright Office's 'side-by-side' test." Varsity Br. 35. Not so. Star Athletica's approach is not a departure from past practices in the courts or the Copyright Office. Rather, by relying on the objective facts about each work instead of idiosyncratic perceptions, Star Athletica's approach guides the application of the "side-by-side" test so that separability determinations may be more consistent.

The "side-by-side" approach, though conceptually correct, offers little guidance for application. It requires the factfinder to "visualize[ ]" or "imagine[ ]" the artistic features and the useful article separately, and to find separability only when, in the person's imagination, the former can exist as a "fully realized . . . artistic work" and the latter a "fully realized . . . useful article" without "[m]erely analogizing the general shape of a useful article to a work of modern sculpture." Compendium III § 924.2(B).

Without additional guidance, the side-by-side approach is akin to a Rorschach test. Try applying it to the mannequin head and its features at issue in *Pivot Point International, Inc.* v. *Charlene Products, Inc.*, 170 F. Supp. 2d 828, 840 (N.D. Ill. 2001):

Mara

Varsity's "side-by-side" test asks the viewer to imagine the mannequin head and the hungry-look facial features separately and determine whether they can each be perceived as "fully realized." Not only did this issue evenly split the four Seventh Circuit judges who addressed it, but a similar mannequin issue confounded the Second Circuit, too. *Pivot Point Int'l, Inc.* v. *Charlene Prods., Inc.*, 372 F.3d 913 (7th Cir. 2004) (2-1 decision reversing Judge Easterbrook in the district court); *Carol*

Barnhart Inc. v. *Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985) (2-1 decision). Like beauty, utility is in the eye of the beholder.

Star Athletica turns this inquiry outward. Starting with the physical-separability tool gives the viewer something tangible to evaluate. *See* Compendium III § 924.2(A). There is no mental exercise of imagining the elements separately; each factfinder would look at the same feature and the same useful article separated from each other to determine whether each is capable of existing independently of the other.

Where physical separation is not possible, the design-process and marketability tools use objective evidence to assist this analysis. Instead of asking the metaphysical question of how a pictorial, graphic, or sculptural feature of a useful article and the useful article are "fully realized," factfinders, aided by experts when helpful, may look to what a designer was engaged to design, see *Pivot Point*, 372 F.3d at 932 (artist given *carte blanche* to implement an idea for a "hungry look" mannequin); whether a designer altered his original sculpture to conform to the demands of a useful article, see *Brandir Int'l, Inc.* v. *Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1147 (2d Cir. 1987) (designer adapted original elements of a sculpture to accommodate and further the utilitarian purpose of a bicycle rack); or whether there is a market for the artistic feature without the useful article, see *Galiano* v. *Harrah's Operating Co.*, 416 F.3d 411, 421–22 (5th Cir. 2005). Courts need such a determinate base to assess separability.

Varsity mocks Star Athletica's acknowledgment of a "sub-optimal" element in its test without noticing that the lack of guidance provided by its

side-by-side analysis is what led to the proliferation of separability tests. As the Fifth Circuit noted, a determinate separability analysis that is less than perfect is preferable to subjective analysis which leads reasonable jurists to opposite conclusions in near every case. See *Galiano*, 416 F.3d at 421–22.

III. Star Athletica's test best effectuates Congressional intent as expressed in § 101.

Varsity says Star Athletica's approach "is divorced from the statutory text." Varsity Br. 17. But Star's test closely tracks § 101, giving each word meaning. Star Br. 26–36. Varsity distorts the text.

A. An article's utilitarian aspects must be identified consistent with § 101's text.

1. Varsity misconstrues the phrase "the utilitarian aspects of the [useful] article."

Varsity acknowledges that Congress crafted § 101 to avoid providing copyright protection for works of industrial design. Varsity Br. 8. But Varsity tries to frustrate Congress's intent by claiming the Court should not consider the functionality of useful articles when determining how to assess separability, then defining the utilitarian aspects of a useful article contrary to the statutory text.

1. To begin, Varsity is wrong that defining a useful article's functionality is not within the scope of the question presented. Varsity Br. 41, 55 n.18. The question asks "what is the appropriate test to determine when a feature of the design of a useful article is protectable" by copyright. That test necessarily includes defining the utilitarian function of the useful article.

2. Section 101 defines a useful article as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. Congress thus considered portraying the article's appearance and conveying information to be utilitarian functions, contra Varsity Br. 21; Congress simply made clear that if those are an article's *only* intrinsic utilitarian functions (like a newspaper), the article can be copyrighted *notwithstanding those utilitarian functions*. The Copyright Office has recognized that a useful article can have such a utilitarian function and other intrinsic utilitarian functions, thus requiring a separability analysis. E.g., 56 Fed. Reg. at 56,531 (costumes have intrinsic utilitarian functions of clothing *and* masquerading.

The meaning of the word "utilitarian" does not exclude portraying an article's appearance or conveying information. "Utilitarian" means "pertaining to or consisting in utility . . . having regard to utility or usefulness rather than beauty, ornamentation, etc." *Random House Webster's Unabridged Dictionary* 2099 (2d ed. 2001). "Utility" means "the state or quality of being useful." *Ibid.* A sign has the utilitarian function of conveying information.

Varsity's approach requires the conclusion that Congress intended "utilitarian aspects" in the separability analysis to have a narrower meaning than "utilitarian functions" in the useful-article definition. If so, the definition of pictorial, graphic, or sculptural work in § 101 would conclude:

> [T]he design of a useful article . . . shall be considered a [protectable] work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that [are

> separable from] the utilitarian aspects of the article *other than portraying the appearance of the article or conveying information.*

Varsity's rewriting of § 101 undermines Congress's acknowledged intent to preclude copyright protection for industrial designs—i.e., designs that optimize a useful article's appearance.[2]

3. Varsity suggests that interpreting utilitarian aspects of a useful article to include conveying information and depicting the article's appearance will result in the loss of copyright protection for logos and anything else printed on a t-shirt. Varsity Br. 44–45; accord U.S. Br. 24–25. Not so.

First, the statute requires consideration of "the utilitarian aspects of *the article*" at issue. Consider Varsity's example of a t-shirt with a team logo on it. Varsity Br. 44. The shirt does not have the utilitarian function of identifying the wearer as a team's fan; the logo performs that function. Likewise, adding a face, character, or landscape to a t-shirt might draw attention to the shirt, but it does nothing to advance the utilitarian function of accentuating or altering the appearance of the wearer's body. That is why sports-team logos or Van Gogh paintings are

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[2] "The dominant feature of modern industrial design is the merger of aesthetic and utilitarian concerns. It is the influence of nonaesthetic factors, the nexus between what the product must do and how it must look, that distinguishes true industrial design from other artistic endeavors. The industrial designer is subject to the functional constraints inherent in each undertaking." Robert C. Denicola, *Applied Art & Indus. Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 739 (1983).

separable from the t-shirt. Indeed, logos and paintings are typically registered as stand-alone works, not works incorporated into garments, as here.

Second, one can possess a copyright in a drawing of a useful article without possessing a copyright in the article. U.S. Br. 23. While a two-dimensional image of a tuxedo may be printed on a t-shirt, U.S. Br. 9–10, the image does not prevent a tailor from making the tuxedo. Only Varsity can print its sketches of cheerleaders wearing uniforms on t-shirts, but anyone can make the actual cheerleader uniforms. *Jack Adelman, Inc.* v. *Sonners & Gordon, Inc.*, 112 F. Supp. 187 (S.D.N.Y. 1934) (copyright in the photograph of a dress does not create a copyright in the dress itself); see 17 U.S.C. § 113(b).

Third, uniforms *qua* uniforms have specific utilitarian functions. By nature, uniforms denote that the wearer belongs to a particular group and not others. Members of the armed services wear uniforms to distinguish themselves from civilians. Toni Pfanner, *Military uniforms & the law of war*, Int'l Rev. of the Red Cross 93–94, 123 (Mar. 2004). Likewise, cheerleading uniforms serve to identify wearers as cheerleaders.[3] See Pet. App. 55a–56a. That fact explains why the cheerleader-uniform designs depicted in the Norman Rockwell painting and the picture of SMU's 1950s cheerleaders are less effective as cheerleader uniforms than the designs at

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[3] Varsity uses this intrinsic function of uniforms to increase its sales. Varsity Brands, Inc., Annual Report (Form 10-K), at 4 (Feb. 14, 2003).

issue here. Compare Varsity Br. 57; U.S. Br. 39; with Star Br. 4–5; J.A. 81–83, 192–94, 213–15.

That useful items change over time is neither surprising nor relevant. Stop signs were not always red and octagonal. Over time, a red octagon has become synonymous with the command to stop. Hilary Greenbaum & Dana Rubinstein, *The Stop Sign Wasn't Always Red*, N.Y. Times, Dec. 11, 2011, at MM30. So too, the development of cheerleader uniforms; the blank shell tops and skirts that Varsity created are unrecognizable today as *cheerleader* uniforms. Star Br. 45.

Finally, Varsity does not dispute that its uniforms are intended to enhance the attractiveness of the wearer. As explained in Star Athletica's opening brief, that is what Varsity's designs accomplish. Star Br. 54.

2. "Utilitarian aspects" must be identified in the context of "the article."

Even though the government recognizes that Varsity's artwork is designed *for* cheerleader uniforms, U.S. Br. 16, the government insists on a separability analysis focused on the utilitarian aspects of the entire genre of "clothing." U.S. Br. 17; see also Pet. App. 45a. Clothing encompasses everything from a parka to a bikini, and all clothing covers at least some of the body. But different kinds of clothing have different intrinsic functions. As noted above, uniforms—and in particular, cheerleader uniforms—have functions that parkas and bikinis do not. Congress requires courts to assess separability based on "the utilitarian aspects of *the article*." 17 U.S.C. § 101 (emphasis added). It violates that

command to analyze utilitarian aspects of "clothing" generically rather than "the article" actually at issue here: cheerleader uniforms.

3. Section 113(a) does not change the result in this case.

The government argues at length that the question presented is subsumed by Copyright Act § 113(a). U.S. Br. 17–24. The government says that because Varsity has copyrighted pictorial or graphic works, 113(a) gives Varsity the right to reproduce the works on a cheerleader uniform or on any other article. But as explained above, the arrangement of stripes, chevrons, and color blocks is a utilitarian aspect *of a* cheerleader uniform. And the government concedes that if this is so, "then Section 113(a) would not protect the application of" those features. U.S. Br. 23. So § 113(a) does not change the analysis.

B. It is appropriate in close cases to apply the statutory general rule against copyright protection for useful articles.

Congress has long been concerned with the misuse of copyright law to prevent competition. Star Br. 10 (citations omitted). For that reason, it established a general rule that useful articles could not be copyrighted, subject to a narrow exception. The design of a useful article can be copyrighted "if, and only to the extent that" it contains pictorial, graphic, or sculptural features that can be identified separately from and exist independently of the utilitarian aspects of the useful article. 17 U.S.C. § 101. Even then, the design is protected "only to the extent" that the features are separately identifiable and capable of independent existence. *Ibid.* Indeed, Congress broadened the scope of unprotectable

useful articles from the Copyright Office's existing regulations, which limited useful articles to those things whose "sole intrinsic function . . . is its utility." 37 C.F.R. § 202.10(c) (1959); see IP Law Profs. Amici Br. in Supp. of Pet'r 5–6.

Given Congress's general policy against copyrighting useful articles, if a court cannot determine whether a design of a useful article can be copyrighted after applying a complete separability analysis, it is appropriate to rule that the article is in the public domain. Contra Varsity Br. 45–47.

C. Varsity's additional criticisms of Star Athletica's approach are unfounded.

1. Varsity contends that the Act does not require a useful article to retain its functionality without the artistic features.[4] Varsity Br. 21, 24 n.4, 34. But § 101 requires the features to "exist independently," which means that each article and feature stands on its own. Compendium III § 924.2(b) ("the artistic feature and the useful article could both exist side by side *and be perceived as fully realized, separate works*" (emphasis added)). If Varsity is correct, any artistic feature can be copyrighted, and there is no need for a separability test. That is why the government disagrees with Varsity: "If the work and the article can be visualized as two different things, *with the article remaining similarly useful (and the work non-useful)*, then the work can be 'identified separately' and 'exist[ ] independently' of the

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[4] In fact, Varsity goes further and suggests a pictorial, graphic, or sculptural work can have some utilitarian contribution to the useful article and *still* be separable. Varsity Br. 21, 24 n.4.

article."). U.S. Br. 29 (emphasis added); accord *id.* at 26. Here, the artistic or aesthetic features of Varsity's designs "exist only as part of a cheerleader uniform," and therefore Varsity is claiming protection in the design of a useful article. IP Law Profs. Amici Br. in Supp. of Pet'r 17.

2. Varsity criticizes Star Athletica's use of a design-process analysis. Varsity Br. 35–38. Star preemptively addressed many of these criticisms, see Star Br. 34–35, 40–41. Varsity's new complaint is that the analysis is "implausibly narrow because it provides no way to distinguish between industrial design and applied art." Varsity Br. 36. Wrong. If a designer is adding a picture to a pre-existing useful article, that picture will be protected; if the designer is creating the design of the useful article, design features are unlikely to receive protection. That is consistent with Congress's policy in § 101.

Varsity is also wrong to say that a design-process analysis would produce "the wrong result under the facts of *Mazer* [v. *Stein*, 347 U.S. 201 (1954)]." Varsity Br. 37. The analysis does not care that the *Mazer* statuette was primarily intended to be *used* as a lamp base. *Ibid.* The question is whether the statuette's design reflects artistic judgment "exercised independently of functional influence." Star Br. 34 (citation omitted). Lacking any objective evidence of functional influence, a court would conclude the statuette is protectable.

Varsity concedes the design-process approach can be useful to demonstrate that a designer "was not constrained in any way by functional concerns." Varsity Br. 38. And of course the benefit of the design-process approach is that the opposite is also true—evidence that a designer was limited by

functional considerations strongly suggests the design at issue is functional.

3. Star Athletica also anticipated many of Varsity's criticisms of the marketability analysis. Compare Varsity Br. 38–41 with Star Br. 35–36, 41–42. In addition, Varsity misconstrues the marketability analysis's usefulness. The analysis does not turn on a "judge's personal taste," nor does it require an author to prove market popularity. Contra Varsity Br. 39. The analysis asks the objective question whether the design feature "would still be marketable to some *significant* segment of the community" without its utilitarian function. Star Br. 35 (citation omitted). The approach's usefulness is demonstrated here: a Van Gogh or Klimt painting (neither a useful article) would be marketable to a significant segment of the community on its own. U.S. Br. 18–21. The same cannot be said of Varsity's cheerleader-uniform designs. That reality is a useful data point.

D. Star Athletica correctly draws a distinction between a garment with two-dimensional artwork printed on it, and a garment design.

As Star Athletica explained in its initial brief, the statutory separability approach confirms that the Copyright Act does not provide a century's worth of monopoly protection to cheerleader uniforms, which are industrial designs. Star Br. 44–51. The same is not true of the two-dimensional examples proffered by Varsity's *amici*.

Consider the Van Gogh, Klimt, and Mondrian prints on dresses. U.S. Br. 18–21; Fashion Law Inst. Amici Br. 27. These prints can obviously be identified

"separately from . . . the utilitarian aspects of" the dress. And the designs are "capable of existing independently of [ ] the utilitarian aspects of" the dress." The dresses do not depend on the paintings for their utility; the paintings were conceived entirely apart from any functionality of the dress, and there is a substantial market for the paintings themselves (i.e., as artwork, not as decorative features of a dress). Conversely, Varsity's cheerleader uniforms do depend on Varsity's designs for their utility

"For the vast majority of clothing," features "are not separable because, in general, most clothing designs are dictated by utilitarian considerations." Gersel & Hemphill Amici Br. 19. That is particularly true of cheerleader uniforms, and this Court should not rewrite the Copyright Act to create new protections.

IV. Varsity's cheerleader-uniform designs are not separable from the actual cheerleader uniforms.

Varsity's cheerleader-uniform designs are not separable under either parties' assessment of separability.

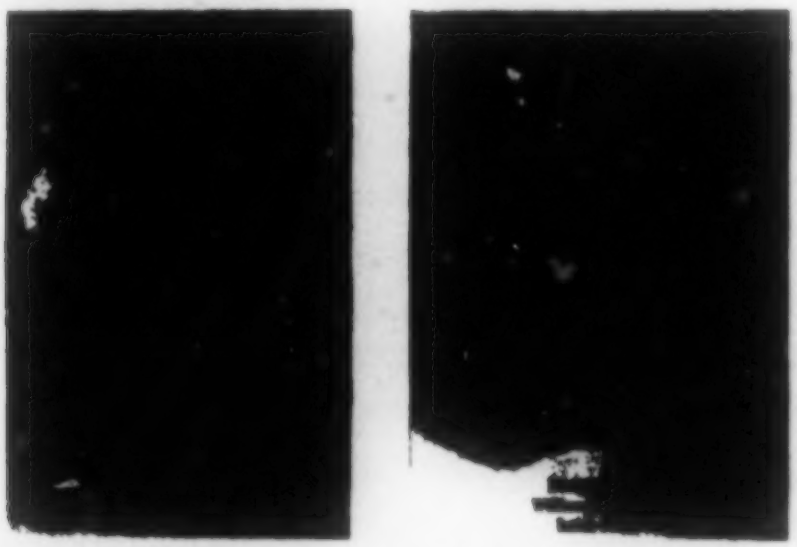
As Star Athletica demonstrated in its principal brief, Varsity's designs are dictated by the intrinsic functions of a cheerleader uniform. Star Br. 44–51. Varsity claims that its "designers are not constrained when creating two-dimensional graphic designs." Varsity Br. 62. Yet Varsity concedes that its designs were constrained by the edges of the uniforms. Varsity Br. 11. And it is undisputed that Varsity's cheerleading uniform designers sketch their designs on the outline of a cheerleader. Star Br. 13. If

Varsity's designers were turning out uniform designs for Scottish Highlanders or the Tower of London's yeoman warders, they would soon be looking for other work. The design-process approach suggests that Varsity's cheerleader-uniform designs are not separable from the cheerleader uniforms.

The same is true of the marketability approach. There is no market for Varsity's arrangements of stripes, chevrons, and color blocks except as cheerleader uniforms. Varsity says that its drawings have been applied to "many other products," Varsity Br. 11, 62—but all of those products are cheerleading related, J.A. 242–43, 258, 261, 273–79, 281 (cheerleader jackets, practice wear, and warm-ups). Varsity relies on its expert, who thinks Varsity's designs could be applied to other objects, but the fact remains that there is no such market or Varsity would already be exploiting it. The marketability approach also suggests that Varsity's cheerleader-uniform designs are not separable.

Under Varsity's side-by-side approach, Star Athletica also prevails. That is because "the aesthetic elements of a cheerleader uniform exist only as part of a cheerleader uniform. There is nothing to extract; the claimant claims the design of a useful article." IP Profs. Amici Br. in Supp. of Pet'r 17.

In addition, the government concedes that "the use of fabric strips 'to create style lines and to minimize the stretching of neck and waist openings while strengthening the neck and waist hems and hem stitching' is the sort of design technique that cannot receive copyright protection." U.S. Br. 33. That is the effect of Varsity's designs, all of which were conceived and created as cut-and-sew garments. Star Br. 14.



R.176, Ex. BB, Goldaper Suppl. Decl. at Ex. F1; accord J.A. 361–63.

Until Star Athletica demonstrated that Varsity's designs served these structural functions, Varsity only produced the designs at issue as cut-and-sew garments. *Id.* at 16; contra Varsity Br. 17, 22, 31, 46. The fact that Varsity later printed images on fabric is irrelevant for the same reason that the outcome in *Jovani Fashion, Ltd.* v. *Fiesta Fashions*, 500 F. App'x 42, 45 (2d Cir. 2012), would be no different if the designer had merely printed images of sequins and tulle on a prom dress—the designs are inseparable from the utilitarian aspects of garments.

Most compelling, consider Varsity's depiction of its cheerleading uniforms without the color blocks, stripes, and braid. Star Br. 45. The blank, white skirts and tops have reduced utilitarian functionality. They do not enhance the wearer's appearance. And they do not identify the wearer as a cheerleader or a member of a particular group of cheerleaders. Even the government concedes that if such utilitarian considerations are properly among "the utilitarian aspects of the [useful] article," 17 U.S.C. § 101, that must be evaluated when determining separability, Varsity's designs are not separable. U.S. Br. 23. Given that these functions must be considered, Star Athletica prevails even under Varsity's test.

V. There is no need to create copyright protection for garments to promote innovation.

Contrary to Varsity's and its *amici's* claims, the courts do not need to expand copyright protection to encourage innovation in the fashion industry. The current copyright regime—which does not protect fashion design from copying—has not deterred innovation or investment in the industry. Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687, 1775 (2006); Kal Raustiala & Christopher Sprigman, *The Piracy Paradox Revisited*, 61 Stan. L. Rev. 1201, 1203 (2009). "Every season thousands of new designs are produced by the large number of firms competing in a market approaching $200 billion in U.S. sales annually. And a significant portion of this output involves copying." 61 Stan. L. Rev. at 1203. The lack of copyright protection "speeds up the fashion cycle

by diffusing designs more quickly, and then driving them toward exhaustion." *Id.* at 1207; *see id.* at 1208 ("copying is helpful" to the fashion industry which "helps explain why fashion design has never been subject to copyright protection").

Varsity's rise to market dominance is a coda on this point. Because fashion design is not protected by copyright, Varsity copied competitors' designs to gain customers—cheerleading squads needing one or two additional uniforms identical to what the squad already had. J.A. 188. On the flip side, Varsity's infringement-actions have prevented the same type of competition, inflating cheerleader-uniform prices. Star Br. 13.

Congress has specifically chosen not to extend copyright protection to fashion design. Instead, Congress provided intellectual-property protection to useful articles in those areas that most readily promote the public's interest in the advancement of Arts and Sciences. This contrasts with the approach other countries have adopted. Fashion Law Institute Br. 18. Congress's choice must be respected.

Finally, Varsity argues that Star Athletica's concerns regarding copyright monopolies are misplaced because designers are free to use the same building blocks as Varsity, provided they do not copy any of Varsity's selections and arrangements.[5]

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[5] Varsity concedes that it is claiming a copyright in the "arrangement" of the various stripes, chevrons, zig-zags, and color blocks. Varsity Br. 50, 62. The actual colors of the designs are irrelevant because the elements act to carry the colors of the school or team to which the cheerleaders belong and are thus related to the cheerleader uniform's identifying function.

[Footnote continued on next page]

Varsity Br. 50–51. Zigzags, chevrons, and stripes are the basic elements of cheerleading uniform designs. J.A. 294, 305. But a designer cannot place zigzags, chevrons, and stripes just anywhere; instead the features must trace the uniform's shape and accentuate certain aspects of the wearer, see generally, J.A. 324–38, or this might be the result:

[Footnote continued from previous page]

Thus, the colors in the deposits are unoriginal; Varsity's expression is an arrangement of empty blocks, i.e., the overall configuration of its uniforms.

Or this:

The cheerleader-uniform designs in the record have a rather banal sameness, see J.A. 324–38, precisely *because* the "building blocks" only perform their function if appropriately placed.

* * *

The parties and the government share considerable common ground. Everyone agrees that the statutory text controls; that utilitarian features cannot be copyrighted; that pre-existing artwork printed onto clothing is usually separable; that two-dimensional works are more readily separable; and that the Sixth Circuit's approach should be rejected. Star Athletica's and Varsity's differences flow primarily from Varsity's refusal to follow the statutory text, especially with regard to the scope of a useful article's utilitarian function. That is because if the arrangement of stripes, chevrons, and color blocks adds utilitarian functionality to a blank athletic

outfit, then Varsity cannot stop Star Athletica from competing. U.S. Br. 23. And honoring the copyright limitations Congress imposed on useful articles promotes the development of "extraordinary ideas" that solve problems and change lives. Amici Br. of Public Knowledge 7 (citing *KSR Int'l Co.* v. *Teleflex Inc.*, 550 U.S. 398, 427 (2007)).

CONCLUSION

For the foregoing reasons and those stated in our opening brief, the judgment of the court of appeals should be reversed.

Respectfully submitted,

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